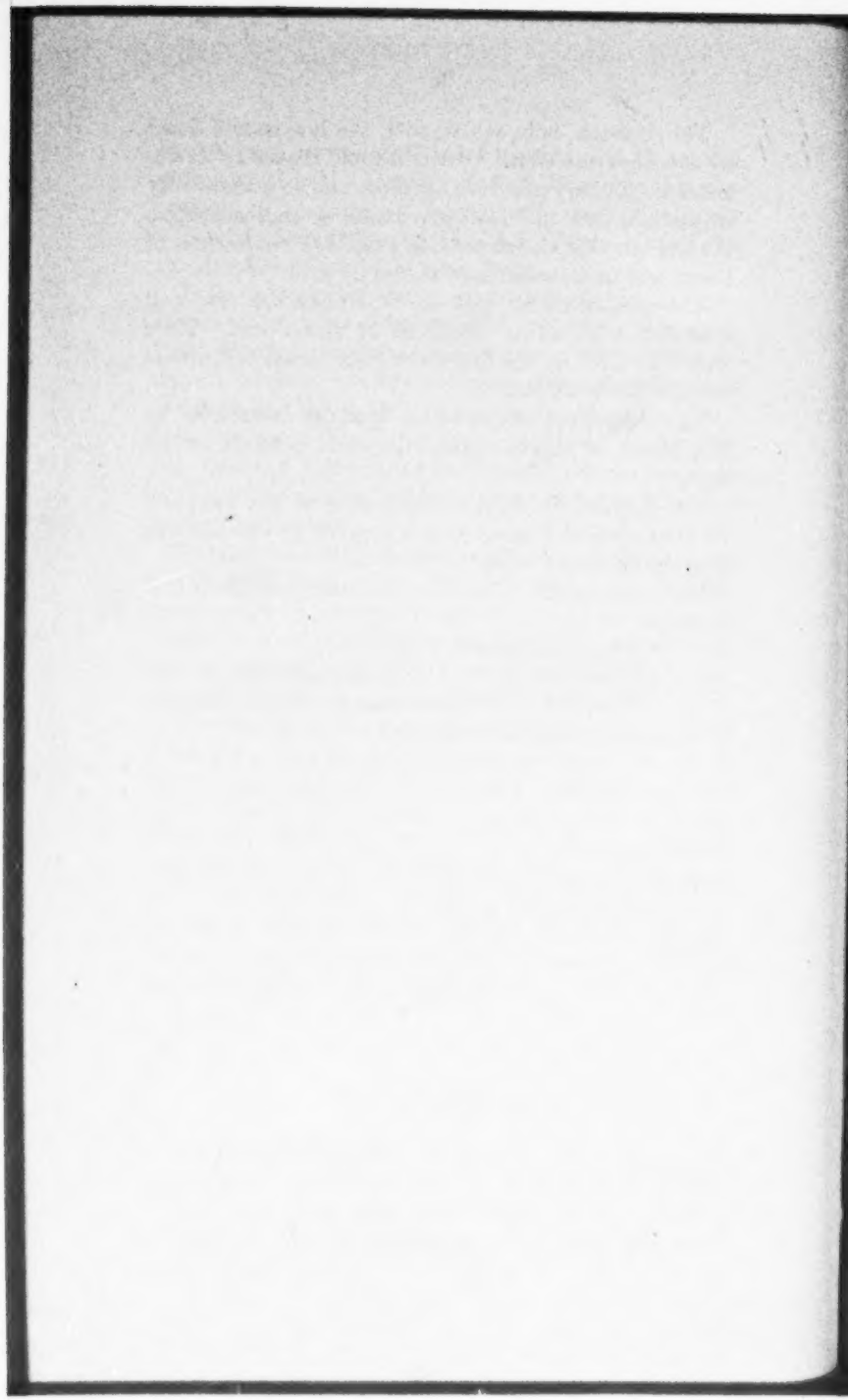

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JAMES H. McKENNEY,
Clerk.

Supreme Court of the United States.

CIMIOTTI UNHAIRING COMPANY and JOHN W. SUTTON,
Petitioners,
vs.
AMERICAN FUR REFINING COMPANY and MAX MISCHKE,
Respondents.

October Term, 1904.

No. 192.

Subject-Matter: Review of decision of the Circuit Court of Appeals for the Third Circuit dismissing petitioners' bill for infringement of Letters Patent of the United States No. 383,258, of May 22nd, 1888, granted to John W. Sutton, for certain improvements in fur plucking machines.

BRIEF FOR RESPONDENTS.

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Supreme Court of the United States.

CIMIOTTI UNHAIRING COMPANY and JOHN W. SUTTON,
Petitioners,

vs.

AMERICAN FUR REFINING COMPANY and MAX MISCHKE,
Respondents.

October Term, 1904.
No. 192.
(19,241.)

SUBJECT-MATTER: REVIEW OF DECISION OF THE CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT DISMISSING PETITIONERS' BILL FOR INFRINGEMENT OF LETTERS PATENT OF THE UNITED STATES No. 383,258, OF MAY 22D, 1888, GRANTED TO JOHN W. SUTTON, FOR CERTAIN IMPROVEMENTS IN FUR-PLUCKING MACHINES.

RESPONDENTS' BRIEF.

Statement.

This cause originated in the Circuit Court of the United States for the District of New Jersey (Third Circuit). The petitioners sued respondents for the infringement of the 8th claim of Letters Patent of the United States No. 383,258 of May 22d, 1888, granted to John W. Sutton, for certain improvements in fur-plucking machines.

The letters patent in suit relates to an improved machine for plucking seals and other skins, and sets forth a machine (p. 149, Rcd.):

> "more especially designed with a view to overcome some of the defects and insufficiencies of the plucking machines heretofore in use, and produce

> the plucking of the skin at the lower parts of the neck and shoulders, where the hairs point outwardly and backwardly and are the most difficult to pluck, as they lie down close to the skin when the same is drawn over the stretcher-bar."

The specification of the patent in suit (p. 149, Red.) recites :

> " The invention consists of a machine for plucking seal and other skins, which comprises a fixed stretcher bar, means for stretching and intermittently feeding the skin over said stretcher-bar, a fixed card above the stretcher-bar near the edge of the same, a rotary separating brush that is intermittently moved up in front of the stretcher-bar, an oscillating guard below the stretcher-bar, a rotary cutting knife and a vertically reciprocating cutting knife working in conjunction with the rotary knife for cutting off the stiff projecting hairs, said rotary cutting knife being provided with a card supported back of the knife, all of which parts are operated from a common driving shaft, so as to produce for each rotation of the same the cutting off or plucking of the hairs projecting from that part of the skin in front of the stretcher-bar."

Respondents' machines are constructed according to an earlier (expired) British patent. They comprise a *movable* stretcher-bar, mechanism for stretching and intermittently feeding the skin, devised to be operated *by the movements of the stretcher-bar*, a compression plate for stretching the skin and holding *both* the fur *and* the stiff hairs from the edge of the stretcher-bar, a *stationary* brush and *stationary* cutters and mechanism for reciprocating the stretcher-bar from the brush to the cutters.

The construction and mode of operation of respondents' machines and of each of their several parts is, in respect to *every* essential feature, different from that of the machine described in the patent in suit. They produce better work and are of more than double producing capacity.

The 8th claim in issue here, as stated in the patent, specifies:—	Respondents' machines in issue here, contain:—	Petitioners pray (pp. 4 & 5 Rcd.) that respondents be enjoined from making and using the machines in issue here and any machines containing the combination of:
The combination of:—		
(1) a *fixed* stretcher-bar	(1) a *movable* stretcher-bar	(1) a stretcher-bar (fixed or movable)
(2) means for intermittently feeding the skin over the same	(2) mechanism for feeding the pelts that is intermittently *operated by the reciprocating movements of the stretcher-bar*	(2) means for intermittently feeding the pelt over the stretcher-bar
(3) a *stationary card* above the stretcher-bar	(3) a spring actuated *compression plate*, acting as tension device upon the pelt	(3) a *guard* device *on one side* of the stretcher-bar
(4) a rotary separating brush below the same	(4) a *stationary rotary* brush	(4) a rotary separating brush *on the other side* of the stretcher-bar
(5) and mechanism, substantially as described, *whereby the rotary separating brush is moved* upward and forward into a position in front of the stretcher-bar,	(5) and mechanism *for reciprocating the stretcher-bar* from the cutters to and along the brush and from the brush to the cutters again	(5) and any mechanism *for causing* the rotary separating brush *to brush the fur downward from the working edge of the stretcher-bar on the off side thereof*, that is, on the side toward which the pelt is fed,
"substantially as set forth"	all parts being constructed and arranged as shown and described in the prior Lake Patent.	(The italics and the words inserted in brackets are not in original.)

The validity of the claim as stated in the patent in suit *was not contested* in this suit. Respondents' defense was that their machines do not contain any of the improvements disclosed in the patent in suit, and particularly do not contain the combination of the elements specified in the claim in issue here, and that this claim *cannot be expanded* as petitioners prayed in their bill:

(1) Because the Court has no power to enlarge the scope or change the wording of the claim, even if it *could be* shown that the invention *was* broader than specified in the claim.

(2) Because in view of what was known and used in prior art the litigated claim is *restricted* to what is specified therein; and

(3) Because the claim, *if expanded* as petitioners pray, *would be anticipated* by prior art, and therefore void in law.

Petitioners contended that because the Circuit Court of Appeals for the Second Circuit affirmed an order of injunction in their case against the Nearseal Unhairing Co. (113 Fed., 588, affirmed 115 Fed., 507), expanding the claim in issue here, as worded in the prayer of their bill, such expansive construction of the claim should have been followed or accepted as *res judicata* in the Third Circuit against the respondents herein.

The Circuit Court for the District of New Jersey sustained the bill and entered an interlocutory decree as prayed for. The Circuit Court of Appeals for the Third Circuit reversed this decision, sustained the defense of non-infringement, and remanded the case to the Circuit Court with instructions to dismiss the bill of complaint herein, with costs.

With reference to the above recited petitioners' contention the Court of Appeals said (p. 241, 242, Red.):

> "We deem it proper to say that the decisions in the Second Circuit involving this patent have been

carefully considered. We do not understand that a machine such as is here in question was involved in those cases or has ever been passed upon. If, however, the construction there given this claim be so broad as to cover the respondents' device, we cannot, in view of what we have said above, accede to such view."

Synopsis of Respondents' Argument.

Though the Supreme Court granted the writ of *certiorari* on the petition alleging a conflict of decisions between the Circuit Courts of Appeals for the Second and Third Circuits, respondents rely on the dictum of this Court in *Mast Foos & Co. vs. Stover Mfg. Co.*, 177 U. S., 485, as absolving them from discussing the proposition as to whether there is or is not a conflict of decisions.

Respondents' argument is therefore directed solely to show that the decision of the Circuit Court of Appeals for the Third Circuit is right in law and amply sustained by the evidence in the case.

Respondents' machines do not contain any of the improvements disclosed in the patent in suit, and particularly do not contain the combination specified in claim here in issue.

The determination of this only issue in the case, by the Circuit Court of Appeals for the Third Circuit, is entirely in accord with the law declared by the decisions of this Court in *Kokomo Fence Co. vs. Kitselman*, 103 O. G., 1422, and in *Water-Meter Co. vs. Desper*, 101 U. S., 332; *Weatherhead vs. Coupe*, 147 U. S., 322; and *Wright vs. Youngling*, 155 U. S., 47, cited in the opinion of the Court of Appeals—and with the proofs in the case.

Respondents also submit, that *any* expansive construction or re-wording of the claim in issue here would be contrary to the law as laid down in numerous decisions of this Court, particularly in the following cases:

U. S. Repair and Guarantee Co. vs. Assyrian Asphalt Co., 98 O. G., 582 (585).

Keystone Bridge Co. vs. Phœnix Iron Co., 95 U. S., 274.
Railroad Co. vs. Mellon, 104 U. S., 112.
White vs. Dunbar, 119 U. S., 47.
McLain vs. Ortmayer, 141 U. S., 419.

In these cases this Court of last resort stated as the fundamental rule for construing claims of a patent, that the Court has no power to enlarge the scope of a claim or to change its wording, and that this rule cannot be deviated from, even in cases where it is or *can be* shown that the original invention *was broader* than specified in the claims.

In the case here before the Court the evidence of prior art clearly shows the patent in suit to be one for improvements *in specific details* of pre-existing machines, and the claim in issue *restricted to what it specifies by its terms*; the evidence of prior art shows that not even the qualifying terms, strictly specifying the *particular features* and the *specific arrangement* of the elements, can be disregarded. The evidence of prior art also shows that the claim in issue here, if expanded, as petitioners pray, to cover respondents' machines, *would be clearly anticipated* by what is disclosed in prior patents, and, consequently void.

The evidence also shows that the machine of the patent in suit was found, and is still, incapable to perform the work for which it was primarily and particularly devised, and that further improvements and substantial changes in its construction were required to adapt it for the work for which it is used now and which was not contemplated by its inventor, such work—unhairing of cheap coney skins—not having come in demand until several years after the issue of the patent in suit.

Respondents' Machines.

The machines in issue here are constructed according to the drawings and description of the English Patent to Lake of June 21, 1888. One of respondents'

machines, selected by petitioners' counsel and expert (p. 22, Q. 138 *et seq.*, Red.) is introduced in evidence and shown in the photograph, "Complainants' Exhibit, Photograph of Defendants' Machine" (p. 16, Q. 77, Red.), not reproduced in the record. The machines were built by Mr. Mischke, one of the respondents herein. He testified (p. 12, Q. 14, Red.) that the twenty-five machines in respondents' shop are like the machine introduced in evidence, that all these machines were constructed according to the specification and drawings of the English patent to Lake No. 2836 of June 28, 1881 (p. 22, x-Q. 140, Red.), and that the respondent corporation did not and does not operate any other machines (p. 18, Qs. 97, 98, Red.).

In the construction of these machines only one brush (the intermediate brush D^1) is used, the other brush being omitted as suggested in the specification of the Lake Patent. The brush and the cutters are set in fixed bearings some distance apart from each other. The stretcher-bar and the mechanism for feeding the pelt are mounted in a movable frame. This frame is set on a shaft rocking on eccentrical bearings that are connected by levers and links with a grooved cam set on the main shaft. This cam has a depression and a protuberance acting on the pin set in the end of the lever connecting it with the eccentric bearing of the frame. Thereby the eccentric bearing of the frame is turned as the frame supporting the stretcher-bar reciprocates and thus the stretcher-bar is made to alternately rise above and descend below the orbit of its movement.

There is only *one* moving mechanism in the machines, (crank and connecting-rod) for reciprocally moving the frame supporting the stretcher-bar. This mechanism swings the frame in an arc, and the cam and lever connection with its bearings imparts to it the rising and descending motions. By the reciprocating motions of the frame also the mechanism for intermittently feeding the pelt (at each return motion of the stretcher-bar from the cutters) is actuated. The structure and operation of the machines is more fully explained in

the chapter of this brief dealing with this prior Lake Patent (p. 45 *et seq.*).

The U. S. Circuit Court of Appeals for the Third Circuit (p. 240, Red.), referred to the structure of respondents' machines as follows:

> "The coney industry has led to the adoption by the defendants of the alleged infringing machine, which in its movable, oscillating stretcher-bar follows the general line shown in the Lake English Patent which, as we have seen by the statements of complainants' witness, Shaw, was also not accurate nor adapted to unhairing seals. Whatever may have been the defects of that machine when applied to the costly experimental work of unhairing seal skins, it is clear to us that its general principles were such that a mechanical adaptation of them so as to successfully deal with the cheap rabbit skins of the coney industry was quite as possible as the adaptation of Sutton's unused seal-unhairing machine to the later industry, and in that adaptation we are clearly of opinion the respondents have not embodied the elements designated in the 8th claim of the Sutton Patent.
>
> "The essential and central feature of respondents' construction—that around which all this mechanism centres—is its movable stretcher-bar. Such a reciprocating stretcher-bar, actuated by the same general mechanism, was shown in the Lake patent. This reciprocating movement carries the pelt in the respondents' machine from the brush to the shears, and it feeds the pelt forward over the stretcher-bar edge as well. Its single reciprocating movement covers approximately a quarter revolution of the power shaft. The three separate mechanisms of Sutton for moving the brush to the stretcher-bar, the shears to the same point and feeding the pelt forward are, so to speak, unified in the respondents' single oscillating motion of the stretcher-bar, which substantially modifies or effects all three.
>
> "It is evident that this is not a mere reversal of parts or principles, mere transposition or substitution, but is in substance the embodiment of a single, three-fold effective movement in lieu of the work of three different individual mechanisms. But that is not all. The respondents have found means to unhair pelts by the total omission of the

stationary card, with its teeth and preparatory work, an essential element of Sutton's eighth claim. The fur and hair are neither straightened, separated nor subjected to any such preparatory cardwork in the respondents' device. They use a repression bar of the same general type shown in the repressing blade of the Covert patent of 1884 and the compression plate of the Lake English patent of 1881.

PETITIONER'S CONTENTIONS.

It is not seriously disputed that respondents' machines are constructed in all substantial respects as the specifications and drawings of the English Patent to Lake direct. This fact could not be disputed successfully in view of the exhibit "Defendants' machine." This exhibit compared with the exhibits "Photographs of Lake Model Machine," or with the drawings and description of the Lake Patent, proves it conclusively.

Petitioners contend, however, that certain "differences" were made in construction of respondents' machines and that by deviating from the exact dimensions and from the exact positions of some of these parts, as shown in the Lake Patent drawings, respondents infringe upon petitioners' rights under the patent in suit.

These differences are said to be:

(1) That in respondents' machines the stationary separating brush is set from one-quarter to half an inch *lower*, whereby such brushing action is produced by this only brush as would be produced in a two brush machine by the brush that is *omitted* in respondents' construction.

(2) That the crank arm of the mechanism, reciprocating the stretcher-bar to and away from the brush, is *shortened*, to dispense with the motion of the stretcher-bar beyond the intermediate brush, that would be required if *two* brushes were used.

(3) That the cam, actuating the eccentric bearing to raise and lower the stretcher-bar, is *turned* some degrees forward, to produce the rising motion of the stretcher-bar at the *beginning* of its shortened movement to the cutters, instead of at a point *during* the stroke, as the patent directs in a machine where *both* brushes are used, the stretcher-bar traveling in such a machine *beyond this intermediate brush*, to come in contact with the "farther away brush" which is omitted in the construction of respondents' machines.

Petitioners further contend that the metallic brushes used in respondents' machines have wires five-sixteenths of an inch *longer* than the drawing of the Lake Patent shows, and that the stretcher-bar is not as *blunt* on its edge as it appears in the drawing of the Lake English Patent.

Petitioners' expert witness, Mr. Foster, testified (p. 87, Rcd.):

(1) That the setting lower of the brush from one-quarter to one-half of an inch in conjunction with the mechanism for raising and lowering the stretcher-bar, so presents the fur skin on the stretcher-bar to the brush in the position of D^1 as to secure "something like the result which would be secured by presenting the fur skin to the action of the brushing roll D in a two-brush Lake machine";

(2) that the shortening of the crank produces a shorter motion of the stretcher-bar, saving the travel of the stretcher-bar to the point where, in a two-brush machine, the brush D is located; and

(3) that the shifting of the cam Y is necessary to bring the action of the mechanism for raising and lowering the stretcher-bar in accord with the shorter motion of the stretcher-bar.

These changes, petitioners say, bring respondents' machines within the scope of the claim in issue here, *when "construed" or "reformed"* as they prayed in

their bill and as they contend it should have been construed by the Circuit Court of Appeals for the Third Circuit.

Petitioners contend that the inventors of the Lake English Patent, when directing that the brush D (the brush farther away from the cutters) may be dispensed with, contemplated only that the brush was to be removed and *nothing else done* in the machine, and that *because* in respondents' machines the stated "changes" were made and the mechanism adjusted accordingly, respondents' machines are not such machines as contemplated by the specification and drawing of the prior Lake Patent.

These Contentions, We Submit, Are Not Only Without Merit; They Are Wholly Fallacious.

In the specification of the Lake English Patent is stated (p 218, Rcd.) that by the mechanism raising and lowering the reciprocating stretcher bar a longer or shorter brushing action can be produced, and that *by* such construction one of the two revolving brushes (the farther away from the cutters) may be dispensed with.

> "* * * Further in this connection, where reference is made to the descent of the stretcher-bar, it states that this gradual descent occurs 'as the bar moves under the brushing roll D^1, and thus it describes a curve like a concave to the roll, and in this manner a longer or shorter brushing action can be produced.' Certainly this description refers to the action of the brushing roll D^1 * * *"
>
> From petitioners' expert witness testimony on the Lake Patent (p. 115, Rcd.).

Petitioners' expert witness Mr. Foster also admits (p. 110, x-Q. 118, Rcd.) that the mechanism *with its parts in the positions shown in the drawings* of the Lake English Patent *does* produce the descent of the

stretcher-bar in one swing, and the ascent in the return swing. He further admits (p. 105, x-Q. 88, and p. 112, x-Q. 127, Rod.) that these ascending and descending motions of the stretcher-bar *result from the configuration of the cam F* " through the eccentric C^1," and that the larger the protuberance and the depression, or, in mechanical parlance, the greater the "*throw*" of the cam, the *greater* (rising and descending) *movement* is imparted to the stretcher-bar. He also understands (p. 140, x-Qs. 210, 211, Rod.) that if the size of the cam is increased, or of the eccentric on the shaft C^1, the raising and lowering motion of the stretcher-bar *would be correspondingly increased*, and (p. 112, x-Q. 128, Rod.) that the relative positions of the protuberance and of the depression of the cam *determine the point* at which the raising and lowering of the stretcher-bar occurs. The protuberance and the depression of the cam are marked 1 and 2 respectively on Fig. 1 of the drawing reproduced on opposite page. The drawing printed in the record (p. 103, x-Q. 83) does not show these marks.

Mr. Foster also admits (p. 100, x-Q. 72, Rod.) that the mechanism whereby the stretcher-bar is raised and lowered during its reciprocating motion to and from the cutters *is fully described and shown in* the Lake Patent.

Petitioners contend that the specification of the Lake Patent is not clear or intelligible. They called this expert witness to testify in support of this contention.

If the inventors of the Lake machine described and illustrated the mechanism so clearly, that even this *adverse* witness was constrained to admit so much of his understanding of what the Lake Patent explains, if this witness cannot deny to be able to see that "*by such construction*" a longer or shorter brushing action *can be produced* by the brush D^1 when the other brush is dispensed with, as the specification directs, how much more readily will *any one else*, familiar with the art, approaching the subject *without a bias*, compre-

A.D. 1881. JUNE 28. № 2836.
LAKE'S COMPLETE SPECIFICATION.

(SHEET)

DEFT'S EXH.
FOSTER'S MARKED DRAW'G
OF LAKE PATENT

FIG 1.

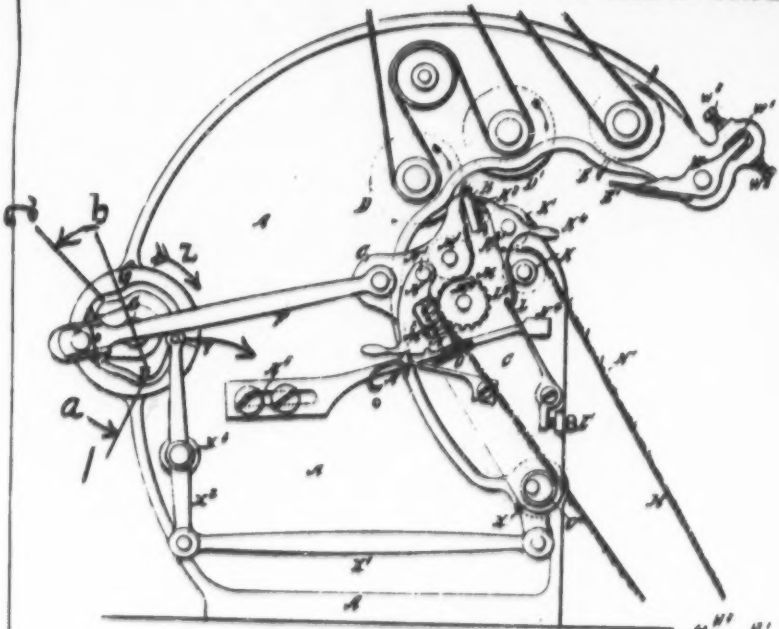
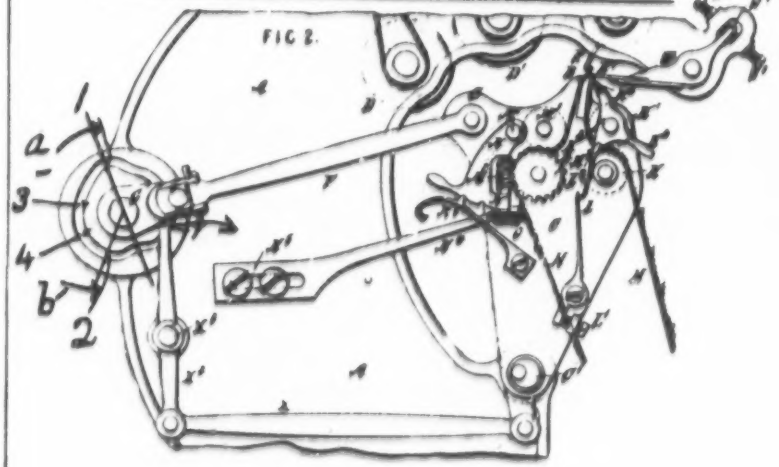


FIG 2.



hend, what is to be done to produce "by this construction" a longer or shorter brushing action?

Upon what ground can, in view of all this, the fallacious contention be sustained that the inventors contemplated only to remove one brush and do nothing with this *mechanism*? What would be the use of encumbering the machine with this ingenious mechanism if the longer or shorter brushing action was to be produced merely by removing one, or by using both brushes?

The evidence of Mr. Mischke proves positively that a mechanic, skilled in the art, can readily, by following the descriptions and drawings of the Lake English Patent, construct a practically operative and a *very efficient* unhairing machine; one wherein two or only one brush may be employed. The "Green Model" or No. "4 Machine" is such machine, constructed as shown and described in the Lake English Patent and the testimony in the case proves, that it is a mechanically and commercially efficient unhairing machine.

Mr. Mischke testified with reference to this machine:

> (Page 23, Red.) "x-Q. 143. Did you build the machine exactly according to the drawings an specification of the Lake English patent? Yes; I built it exactly according to the drawings that were furnished me by Mr. Searle. I understand the specifications of the Lake patent thoroughly and built it exactly according to them, to the best of my ability.
>
> x-Q. 144. Did you operate this machine after it was constructed? A. Yes.
>
> x-Q. 145. Did it unhair skins? A. Yes.
>
> x-Q. 146. Did it work satisfactorily? A. Yes; in fact it worked very satisfactorily.
>
> x-Q. 147. Did you try to operate the machine with only the one intermediate brush designated D^1 in the drawing of the Lake English patent? A. Yes, I did.
>
> x-Q. 148. Was the machine found capable of operating with only this one brush? A. Yes, it operated much faster and produced still better work than with the original Lake machine, built exactly according to the specification."

(Page 27, Rcd) "x-Q. 180. What is necessary to be done to make a machine constructed according to the Lake English patent, as you have testified, to operate with one brush only? A. I lower the brush from about one-quarter to one-half an inch and shorten the back and forward motion of the stretcher-bar and slightly turn the cam forward, so that when the stretcher-bar first comes in contact with the brush it rises immediately.

x-Q. 181. When you say 'I lower the brush,' which of the two brushes of the Lake machine do you mean? A. The brush D^1—the intermediate brush.

x-Q. 182. Please explain how you shortened the back and forward motion of the stretcher-bar? A. I simply used a longer connecting rod, which is connected with the crank on the main shaft of the machine to the swinging frame, and which also had two holes in it. I shortened the crank on the main shaft so as not to cause the stretcher-bar to make such a long motion.

x-Q. 183. Can you state approximately how long a time it requires to make these changes from a two-brush to a one-brush machine, constructed according to the Lake English patent? A. About half an hour."

(P. 28, Rcd.) Re-d. Q. 194. Heretofore you testified that in a so-called Lake machine, with two brushes, the D^1 brush brushed the fur below the edge from one-eighth to three-sixteenths of an inch. As a matter of fact is that what the D^1 brush does in a two-brush Lake machine? A. Yes.

(P. 29, Rcd.) Re-d. Q. 204. Does the Lake Patent contain any statements that the cam is to be set differently; that the brush is to be lowered, and that the crank arm is to be shortened when the D brush is dispensed with? A. No, not necessarily; but common sense would show to any half a machinist what to do."

His answer to the last question states succintly the *only* faculty required by any one, familiar with mechanical construction, to understand what is necessary or expedient to do in such machine, and how to adjust the parts when it is desired to work with *one* brush only. The adjustments certainly do not require any inventive act. No more than plain common sense is neces-

sary to understand what is to be done. Mr. Foster's contention, that by thus adjusting the mechanism as explained, respondents *converted* the Lake machines into an infringement of the patent in suit, is not common sense. No one having common sense and mechanical training will agree with him on this point.

The "Metallic Brush, Having Long, Flexible Teeth, Over One-half Inch Long."

Petitioners further contention as to the "differences" between the Lake English machine and respondents' machine is stated by Mr. Foster on page 80, as follows:

> "In defendants' machine, the single brushing-roll employed is not covered with clothing-card or bristles or teasels, but is a *metallic brush* having long, flexible teeth over one-half inch in length, which act as with a wiping action, and not with a drawing action, as in teaseling."

Characteristic of Mr. Foster's testimony is that he previously stated (p. 76, Rcd.) interpreting the description of the Lake English Patent:

> "At the upper part of the machine are the cutters E and E^1 and what are termed 'fur-opening *brushes*,' or 'separating *brushes*,' or '*brushes*' or '*brushing*-rolls'; two of these are shown in the drawing arranged at different heights, designated by the letters D and D^1, etc."

Thus, as Mr. Foster himself quotes, the specification of the English Patent to Lake expressly designates the devices marked D and D^1 as *brushes*. Moreover, in answer to x-Q. 192 (p. 135, Rcd.) Mr. Foster *admits* that metallic brushes with straight teeth *were well known in the art prior to the date of the Lake Patent*, and adds, that "where *brushing*-rolls were referred to, while it was recognized that the teeth *must* be long and flexible and the idea embodied was that of compacting with and pressing down the fibres upon or

along the surface." Thus, according to Mr. Foster's own explanation, the designation in the Lake English Patent of the devices, marked D and D^1 therein, as brushes or brushing-rolls, *meant* that their teeth *must be* long and flexible and their action must be "brushing down the fibres, etc."

Moreover, in answer to x-Q. 207 *et seq.* (p. 139, Rcd.) Mr. Foster admitted that the metallic wires or bristles of such brushes were, as a rule, set in a backing or pad of some flexible material like the material used in the construction of respondents' brushes, and said:

> "Metallic brushes *do not act differently* from bristle brushes, but brushes act differently from a card."

All that Mr. Foster said in respect to the brushes in respondents' machines, dwindles into a proposition submitted to him in x-Q. 67 (p. 98, Rcd.) to the point that whereas, according to *his* interpretation of the drawing of the Lake Patent the bristles there are shown to be *comparatively* short, the diameters of the brushes being large, the diameters of the brushes in respondents' machines are small, and the bristles *comparatively* longer. Mr. Foster "estimates" that the bristles shown in the drawing of the Lake English Patent are about one-quarter of an inch long; whereas, the bristles of the brushes used in respondents' machines are *nine-sixteenths* of an inch long.

Such discrimination is significant. But it is of no importance here, even if it be a fact that the bristles on respondents' machines are five-sixteenths of an inch longer than they appear to be shown in the drawings. If such a change is of any effect, the discovery of that is not Mr. Sutton's; the prior Covert Patent of 1884 shows a separating brush having *very long* bristles. The brush is used *in the same place* and *for the same purpose* as the separating brushes of the Lake Patent or the separating brush of the Sutton Patent in suit.

The "Comparatively" Sharp Edge of the Stretcher Bar.

The last feature of difference between respondents' machines and the machines shown and described in the Lake English Patent, as recited by Mr. Foster (p. 80), is as follows:

> "In defendants' machines, the stretcher-bar is made with a *comparatively* sharp edge, which naturally tends to facilitate the separation of the fur, while in the Lake machine, the stretcher-bar has a rounded edge which does not tend to secure this result."

When his attention was called to Petitioners' Exhibit "Cimiotti Patent," ante-dating the Lake English Patent, and describing an unhairing machine wherein a *keen-edged* stretcher-bar is employed, Mr. Foster admitted, that any mechanic is entitled to use what may be in the prior art. But respondents do not use a keen-edged stretcher-bar. The stretcher-bar they use is tapered, as shown in the Lake English Patent, and slightly rounded. It is not as *thick* as a finger, but that is not what the specification of the Lake English Patent says. It says only that the stretcher-bar shall have its upper edge *slightly rounded* to resemble the form of a finger. Nevertheless, even if respondents would employ, in the structure of their machines, a sharp, keen-edged stretcher-bar, they would not violate any of petitioners' rights under the patent in suit, because such keen-edged stretcher-bars were used in unhairing machines, shown by the *prior* patents in the record here.

The Improvements Disclosed in the Patent in Suit.

The letters patent in suit (p. 149, *et seq.*, Rcd.) relate to machines "for plucking seal skins and other furs, so as to remove the stiff water-hairs therefrom

without injuring the soft hair or wool of the same." This was then an old art, wherein other machines for performing the same work were known and used for many years before the date of the patent in suit. Of these prior machines, those set forth in the patent to Lake of June 28th, 1881 (p. 216, Rcd.), and the patent to Covert of September 9th, 1884 (p. 198, Rcd.), have particular significance, in that they disclose machines of the same sub-class, that is unhairing machines employing rotary brushes to effect the separating of the stiff water-hairs from the fur.

The specification of the patent in suit admits this, saying (p. 149, Rcd.) :

> " The machine is more especially designed with a view to overcome some of the defects and insufficiencies of the plucking-machines *heretofore in use*."

As set forth in the specification, and as shown by the evidence here, the invention of the patent in suit consists of various *improvements in details* of such pre-existing machines of this sub-class.

The U. S. Circuit Court of Appeals says, in its opinion (p. 237, Rcd.), on this point:

> In 1888 Sutton sought, by the patent in suit, to improve on air-blast machines. His device, as stated in his patent, was " more especially designed with a view to overcome some of the defects and insufficiencies of the plucking machines heretofore in use." These defects related to a particular part of the operation, as he desired to " produce the plucking of the skins at the lower part of the neck and shoulders where the hairs pointed outwardly and backwardly, and are the most difficult to pluck as they lie down close to the skin when the same is drawn over the stretcher-bar " and " to dispense with a blast fan or other air forcing devices and produce the removing of the water-hairs entirely by mechanical means, which are operated by power so that a quick and uniform plucking of the skin takes place." It will be particularly noted that the expressed special purpose of his invention was to clip the outwardly pointing hairs at the lower

side of the neck. Sutton's invention is best stated in his own words: "The invention consists of a machine for plucking seal and other skins, which comprises a fixed stretcher-bar, means for stretching and intermittently feeding the skin over the said stretcher-bar, a fixed card above the stretcher-bar near the edge of the same, a rotary separating brush that is intermittently moved up in front of the stretcher-bar, a rotary cutting knife and a vertically reciprocating cutting knife working in conjunction with the rotary knife for cutting off the stiff projecting hairs, said rotary cutting knife being provided with a card supported back of the knife all of which parts are operated from a common driving shaft, so as to produce for each rotation of the same the cutting off or plucking of the hairs projecting from that part of the skin in front of the stretcher-bar. * * * The invention consists further of the mechanisms by which the motion is imparted from the driving shaft to the different parts comprising the machine, as will appear more fully hereafter, and finally be pointed out in the claims."

The machine of the patent in suit is shown in Fig. 1 of the drawings (p. 150, Rcd.), described as a vertical longitudinal section, and in Figs. 2 and 3, which are described as vertical longitudinal sections, drawn on a larger scale.

The parts of the machine are mounted in a rectangular frame, designated A in the drawing. As only the eighth claim of the patent is in issue here, specifying a combination of some parts in their particular arrangement in the machine, only these parts and their functional co-operation will be discussed more fully and the remaining parts will be referred to only to the extent as necessary to elucidate the points in issue:

The Fixed Stretcher-Bar.

The stretcher-bar is the bevelled bar B fixed in horizontal position near the left-hand end of the frame.

> "This fixed stretcher-bar is the centre toward which all the movable operative elements of the machine converge" (Opinion C. C. A., p. 238, Rcd).

The correctness of this conclusion is apparent from examination of any patent in the record, describing an unhairing machine, wherein the stretcher-bar is fixed. The setting of the stretcher-bar in a *fixed* position is one of the characteristic features of such a machine. The fixed position of the stretcher-bar determines the character and particular combination of the other parts and dictates the providing of the several actuating mechanisms for moving the other parts of the machine in such manner and at such times—successively and alternately—as the operation of the machines requires. The pelt to be operated upon is "stretched" over this bar and as the separating of the stiff water hairs from the fur, and the removing (clipping off) of the former is done at the "working-edge" of the stretcher-bar; at least two movable sets of implements are required, one for the separating operation and one for the removing operation.

When the stretcher-bar is fixed, they must be movable, and because they operate at different times at the same point—the working edge of the stretcher-bar—and, because their mode of operation is necessarily different, a separate moving mechanism must be provided for *each* of these implements. Furthermore, *because* the stretcher-bar is fixed and the mechanism for feeding of the pelt must be necessarily arranged where the stretcher-bar is, *still another mechanism* must be provided for actuating the feed.

Therein lies the first determining point of difference between a machine having a *fixed* stretcher-bar and one having a movable one. In the latter only *one* moving mechanism is required, a mechanism for moving the stretcher-bar. The separating implements and the hair removing implements must necessarily be located in different places, and the problem to be solved by devising the moving mechanism is to make it to move the stretcher-bar from one to the other. There are, of course, still other problems to be solved in devising either kind of such machines, but these discussed above are those which are *dictated* by the determina-

tion whether the stretcher-bar is fixed or movable. Either construction has some advantages which the other cannot obtain. The prior Covert Patent of 1884 and the "Covert Machine" are examples of such machines employing a *fixed* stretcher-bar and a movable rotary brush, while the prior Lake Patent sets forth a machine employing a movable stretcher-bar and a stationary rotary brush.

The Means for Intermittently Feeding the Pelts.

These "means" comprise feed rollers B^1 B^1, located near the end of the frame, one above and the other below the level of the stretcher-bar, gear wheels set on the shafts of the feed rollers; tapes (not lettered in the drawing) connected to the feed rollers, and to which the skin to be unhaired is applied, and gear wheels set on the driving shaft S, whereby the feed rollers are intermittently actuated "as customary in plucking machines of this class."

In a machine where the stretcher-bar is fixed, some actuating or motion transmitting mechanism—like the "gear wheels set on the driving shaft S" in the machine of the patent in suit—must be provided to actuate the "means for intermittently feeding the pelt."

The United States Circuit Court of Appeals for the Third Circuit says (p. 238, Rcd.) on this point:

> "It thus appears not only that the stretcher-bar was fixed and therefore incapable of effecting the forward movement of the pelt, but that such forward pelt movement was effected direct from the driving shaft by means independent of the stretcher-bar."

If the stretcher-bar is movable, as in the prior Lake Patent or in respondents' machines, the reciprocating motion of the stretcher-bar may be utilized to actuate the pelt feeding mechanism. The prior Lake Patent and respondents' machines show an example of so utilizing the movements of the stretcher-bar for actuating the feed mechanism.

The Stationary Card.

Above the stretcher-bar B and attached thereto by thumb-screws (not lettered in the drawing), is a "stationary card E." This "card" is described in the specification of the patent in suit as one of the most important parts of the machine (p. 151):

> "Immediately above the stretcher-bar B is arranged a stationary card, E, which is attached to the ends of the stretcher-bar B by means of thumb-screws. (Not shown in the drawings.) The points of the teeth of the card E are close to, but do not touch the surface of the skin, so that the hair and fur are both straightened as the skin is fed forward. The teeth of the card E hold down the fine fur, but permit the stiff hairs to stand up between the teeth, owing to the slow forward movement of the skin, which gives the hairs sufficient time to so adjust themselves."
>
> (p. 152) "When the skin is in place, the stationary card E is drawn backward a few times over that part of the skin that is upon the stretcher-bar B, so as to card back the fur and hair and produce thereby a parting of the fur at that part of the skin then covering the edge of the stretcher-bar. One half of the fur upon that section of the skin will by the parting be kept above and the other half below the edge of the stretcher-bar. This permits the hair upon that section of the skin in front of the edge of the stretcher-bar to rise through the fur and keep its place with less trouble than when more fur is acted upon. When the fur and hair have been carded back by the card E, the same is fastened to the stretcher-bar by thumb-screws. The card is set back from the edge of the stretcher-bar to a distance a little more than one-half of the length of the fur for the purpose of holding the fur and preventing it from moving forward until the forward motion of the skin takes place."

and again (p. 153):

> "The operation of the machine is quick and reliable, the hair being cut off close to the skin and

without injury to the fur, which is held back so as not to be presented to the knives by the action of the stationary card above and the joint action of the separating-brush and oscillating guard below the stretcher-bar."

In prior machines of this class tension or holding devices are used—a smooth bar or plate, not rigidly secured in position but pressing upon the skin either by its own weight, like the plate C of the prior Covert Patent or by a spring-like the compression plate K^2 of the prior Lake Patent.

The "stationary card" of the Sutton Patent in suit is distinguished from the corresponding devices of prior machines by its construction as a *card*, by the manner of its being *rigidly* secured, and so that "the points of the teeth of the card E are close to, but *do not touch the skin*," and by its particular *functions*.

The stationary card E is described as having *three* functions:

(1) To straighten out the hair and fur as the skin is fed forward.

> "The points of the teeth of the card E are close to but do not touch the surface of the skin, so that the hair and fur are both straightened as the skin is fed forward" (Sutton Specification, p. 151, Rcd.).

It is clear that only a *card*, or other implement having *teeth*, can straighten out the hair and fur, and that a flat plate or bar could not perform this function.

(2) To separate the fur from the stiff hairs on the on-side (the side from which the skin is moved toward the edge) of the stretcher-bar.

> "The teeth of the card E hold down the fine fur but permit the stiff hairs to stand up between the teeth * * *" (p. 151, Rcd.).

Also this function can be performed only by a *card* or some similar implement provided with *teeth*.

The necessity that this stationary card should perform this separating function is emphasized in the specification of the patent in suit where the action of the "separating brush" is explained. As described, the separating of the stiff hairs from the fur is performed by these two devices co-operatively; by the stationary card E on the on-side (upper) and by the rotary brush F on the other side (below) of the stretcher-bar. The statement, quoted above, "the teeth of the card hold down the fur but permit the stiff hairs (those to be removed from the skin) to stand up" clearly explains that this *card* E, constructed and located as said above, effects the separating of these hairs from the fur on the "on-side" (upper side) of the stretcher-bar, the same as the brush performs this function on the other side (below) the stretcher-bar.

(3) The third function of the stationary card E is to protect the fur (wool) from the action of the knives.

> "The card is set back from the edge of the stretcher-bar to a distance of a little more than one-half of the length of the fur for the purpose of holding the fur, * * *" (p. 152, near bottom, Rcd.)

and again (p. 153, Rcd.)

> "* * * the hair being cut off close to the skin and without injury to the fur, which is held back so as not to be presented to the knives by the action of the stationary card above * * *"

In its opinion the Court of Appeals says (p. 238, Rcd.) with reference to this card:

> "The next element of the claim is a stationary card above the stretcher-bar. The function and use of this stationary card are shown in the specification: 'Immediately above the stretcher-bar B is arranged a stationary card, E, which is attached to the ends of the stretcher-bar B by

means of thumb screws. (Not shown in the drawings). The points of the teeth of the card E are close to but do not touch the surface of the skin, so that the hair and skin are both straightened as the skin is fed forward. The teeth of the card E hold down the fine fur, but permit the stiff hairs to stand up between the teeth, owing to the slow forward movement of the skin, which gives the hairs sufficient time to so adjust themselves.' Not only is the card's function thus stated but to it is attributed, in combination, the effectiveness of the device. Says the patentee: 'The operation of the machine is quick and reliable, the hair being cut off close to the skin and without injury to the fur, which is held back so as not to be presented to the knives by the action of the stationary card above and the joint action of the separating brush and oscillating guard below the stretcher-bar.'

"It therefore appears that the teeth of the card effected a preparatory functional operation, and the card's importance may be estimated by the fact that it is an element in nine of the eleven claims."

The same views are expressed by Judge WALLACE of the Circuit Court of Appeals for the Second Circuit in the case of these petitioners against the Nearseal Unhairing Co. (115 Fed., 507):

"I dissent from the prevailing opinion in this case because I think the defendant's machine does not infringe the 8th claim of the patent.

"It does not have the stationary card above the stretcher-bar, which is an element of the claim. The patent describes the stationary card, E, as provided with a comb or carding teeth. It is set back from the edge of the stretcher-bar, and the points of the teeth are close to, but do not touch the skin. The specification describes its teeth as performing three functions before the pelt reaches the edge of the stretcher-bar. They straighten out the hair and fur as the skin is fed forward; they permit the stiff hairs to stand up between the teeth; and they hold back the fur and prevent it from moving forward until the forward motion of the skin takes place. The pressure plate of the defendant's machine is not an equivalent of the stationary card of the claim; it has no

comb or teeth, is not stationary, and performs the single function of the pressure plate of the Covert patent. The patent industriously makes the stationary card 'substantially as described' an element of the claim."

The recited quotations from the specifications fully sustain these conclusions. They also show that the patentee Sutton *did* consider and did advisedly describe the "stationary card" as one of the *particular* features of his improved machine and that he did *advisedly* specify this "stationary card" as an essential element of the combination stated in the claim eighth, here in issue.

The Rotary Brush.

This brush, designated by letter F in the drawings, is described in the specification of the patent in suit (p. 151) as follows:

> "The brush F is made of soft bristles and is rotated at a speed of one hundred and fifty revolutions per minute. The soft bristles allow the stiff hairs to stand, while the quick motion of the brush bends the soft hair in downward direction and brushes it below the stretcher-bar."

The "quick motion of the brush" is produced by the "mechanism whereby the brush is moved," etc., the last element of the combination specified in the claim.

The claim describes this brush as "a rotary separating brush." Whether or not this element is to be such *particular brush* as described in the specification "made of soft bristles" and effecting the separating of stiff hairs from the fur in that the "soft bristles *allow the stiff hairs to stand*, while the quick motion of the brush bends the soft hair in downward direction" depends upon what effect is to be attributed to the representations, made in the specification of the patent, by describing such particular brush, as different in this re-

spect, and also in its function, from the rotary brushes employed in machines of prior art. In the prior Covert Patent (p. 198, Rcd.) is stated (p. 199) that the brush draws the fur *together* with the hairs, and that "As the brush leaves the fur, the hairs, by reason of their stiffness and elasticity spring up, etc."

And in another part (p. 200, Rcd.) the Covert Patent says that the fur

> "has not sufficient strength to resist the elasticity of the hairs which have been brushed over *with it*, and which, consequently, instantly spring up, etc."

The rotary brush F of the Sutton Patent, *as described in the specification*, is distinguished in respect to its construction and still more so in respect to its function, from the rotary brushes employed in machines of prior art.

"The Mechanism, Substantially as Described, Whereby the Rotary Brush is Moved, etc."

This last element of the claim in issue here is described on page 151, Record, in connection with the rotary separating brush F, as follows:

> "Below the stretcher-bar B is arranged a rotary separating brush F, which is supported in oscillating arms F^1 that are guided by pins in arc-shaped slots f^1 of fixed guide plates F^1, as shown clearly in Figs. 1, 2 and 3, the oscillating arms F^1 being pivoted to horizontally reciprocating connecting rods F–2, which are provided with yokes *f*–3, having anti-friction rollers at their rear ends and acted upon by cams F–3 on the cam shaft S^1, the cams being so shaped and timed that the forward and upward motion of the brush takes place at the proper time."

The brush is supported in oscillating arms; the oscillating arms are "guided" in arc-shaped slots and are pivoted to "horizontally reciprocating arms"—the

arms are acted upon by cams "so shaped and timed," etc. These features of the brush moving mechanism are required *by the particular arrangement of the parts* of the machine—the use therein, besides the movable brush, of the "reciprocating knife" and of other movable parts, all required to act successively and alternately *at one and the same point*—the edge of the fixed stretcher-bar. Besides that, the operation of the machine, as recited in the specification (p. 153 Rcd.) requires the moving of each of the several movable parts of the machine at a *different* time and *each in a specific way*. This circumstance and the necessity that the brush, moved by this mechanism, be moved quickly and securely in its predetermined path and "at the proper time" as it is explained in the specification of the patent in suit, give additional significance to the phrase "mechanism *substantially as described*, whereby the rotary brush is moved, etc." employed in the wording of the claim. Considered with reference to the specification, these words clearly show the intention to specify *the particular* mechanism, described and shown in the patent, as the element intended to be pointed out in the claim. They also exclude any other that is not "substantially as described."

"The Oscillating Guard G."

Besides the brush F an oscillating guard bar G, provided with soft rubber wipers g, is employed in the machine of the patent in suit for removing the fur, separated from the stiff hairs, from the edge of the stretcher-bar and for holding it on the off-side during the operation of the cutters removing the stiff hairs from the fur skin. This guard bar G moves in arc-shaped slots g^1 of the guide-plates C^1. The oscillating motion of guard G follows the brush F. It takes up the separated fur, carries it farther back from the edge of the stretcher-bar, beyond the reach of the cutting implements, and holds it in that position

while the reciprocating knife C is moved in front of the stretcher-bar and cuts, in conjunction with rotary knife D, the stiff hairs (p. 153, Rcd.). This oscillating guard G of the Sutton patent differs from the corresponding implement (the wiper *f*) of the Covert machine in that it is provided with the "soft rubber wipers *g* and in respect to its particular movements, but they both perform the same important function of taking up the fur where the brush left it, removing it farther from the edge of the stretcher-bar and holding it in this safe position while the knives operate, cutting off the stiff hairs.

The Vertically Reciprocating Knife.

A vertically reciprocating knife C is set below the stretcher-bar on levers C-2 fulcrumed to the frame, and whose rear ends are engaged by cams C-3 set on the cam shaft S^1, as shown in Fig. 1 of the drawing. The motions of this knife C, produced by these levers and cams, alternate with the motions of the brush "F," and guard G, that is to say this knife C is moved to the edge of the stretcher-bar when the brush F and the oscillating guard G, following it, are receded, and is in turn withdrawn to make room for the brush F (and guard G) when they again advance, in the order stated, to the edge of the stretcher bar.

The Rotary Knife D and the Card or Carding Brush D-2.

In front of, and at some distance from, the stretcher-bar B shaft D^1 is set provided with arms *dd* to which a rotary knife D is affixed. Some distance behind the knife D is secured on brackets a carding brush D-2 which acts on that part of the skin that is fed forward over the edge of the stretcher-bar immediately after the hairs of the next preceding section of the skin have been cut off. The rotary knife D co-acts with the vertically reciprocating knife C, when the latter is moved up to the edge of the stretcher-bar, in removing

the stiff hairs. Both the rotary knife D and the carding brush D-2 are operated by the shaft D^1 driven by bevel gears D-3 and D-4 shown in Fig. 7 of the drawing.

The other parts of the machine, designated as laterally reciprocating rubbers and the mechanism for operating them, have no bearing on the issue in this case.

Respondents' Machines do not Contain the Combination Specified in the Litigated Claim.

The Court of Appeals says upon this point (p. 241, Rcd.) as follows:

> "In the means employed by respondent we find an absence of the specific elements of the claim in suit. The respondents have no fixed stretcher-bar; they have no means for intermittently feeding the skin over such a fixed stretcher-bar; they have no stationary card above the stretcher-bar; they have no movable separating brush below such stretcher-bar, and no mechanism whereby a rotary brush is moved upward and forward in front of such stretcher-bar. This shows a non-identity of means, and it is fundamental law that the non-use of any specific element of a combination claim or its equivalent avoids infringement (Water-Meter Co. vs. Desper, 101 U. S., 332; Weatherhead vs. Coupe, 147 U. S., 322; Wright vs. Youengling, 155 U. S., 47)."

This Conclusion is Sustained by the Evidence in the Case. A Comparison of the Structure of Respondents' Machines with the Claim and with the Drawings and Specification of the Patent in Suit Shows that no Other Determination of the Issue Could be Sustained.

Taking up the elements of the claim in the order as they are stated in the patent in suit, we find the "*fixed*

stretcher-bar" specified as the first element of the combination.

In respondents' machines a *movable* stretcher-bar is used. Petitioners contend that a movable stretcher-bar, a stationary brush and mechanism for moving the stretcher-bar is an equivalent of a fixed stretcher-bar, a movable brush and mechanism, substantially as described for *moving the brush.*

The Court of Appeals says (p. 241, Rcd.) on this point:

> The difference between the fixed stretcher-bar and the rotary brush of Sutton and the rotary brush and movable stretcher-bar of the respondents, is not the mere reversal of relations the words indicate. By that change the two separate movements of both shears and brush to the Sutton stretcher-bar and the separate independent mechanical means for accomplishing the two are replaced by the oscillating movement of the stretcher-bar. Nor is this all. The upward and forward movement of Sutton's brush is not translated or reversed into an upward and forward movement of respondents' stretcher-bar, it is substantially done away with in the rocking of the stretcher-bar, and that movement also effects an additional result, viz., the forward feeding of the pelt, which in Sutton was done by independent means and which means he makes an element of his claim. It is therefore apparent that the single reciprocating movement of the stretcher-bar, which in itself was shown years before in the Lake Patent, is not a mere mechanical transposition or subterfuge, but embodies the use of substantially different mechanical principles, movements and means in a wholly different way. When these different principles result, as they do in this case, in a doubled working capacity and product, the conclusion, that there is a difference between the two machines in substance, as well as form, is apparent.

The circumstance, that in respondents' machines a *stationary brush* is used, in connection with a *movable stretcher-bar*, to accomplish the same result as in the patented combination is accomplished by a *movable*

brush, used in connection with a *fixed stretcher-bar* makes it seemingly appear that one is the mechanical equivalent to the other. But in fact it is not so :

(1) because the mechanism for moving the stretcher-bar cannot be used for moving the brush and *vice versa ;*

(2) because in a machine, having a fixed stretcher-bar and a movable brush, *several* and differently acting moving mechanisms must be provided, while only *one* moving mechanism is required in a machine having a movable stretcher-bar and a fixed brush ;

(3) because the substitution of a movable brush and a fixed stretcher-bar for a fixed brush and a movable stretcher bar requires a complete reorganization and reconstruction of the machine, addition of new parts and a changing of the mode of operation of the parts.

1. The mechanism for moving the stretcher-bar cannot be used for moving the brush, and vice versa.

This first proposition requires no argument beyond saying, that, taking for example respondents' machine and the machine of the patent in suit, the mechanism of Sutton's machine for moving the brush could not be used for moving the stretcher-bar either in that machine or in respondents' machine, nor could the mechanism for moving the stretcher-bar of respondents' machine be used for moving the brush in respondents' or in the Sutton machine.

Next is the question, can the mechanism for moving the stretcher-bar used in respondents' machine be utilized for moving the brush in either machine.

We think not ; we are unable to conceive how it could be done. The mechanism could move the brush only in the same path as it now moves the stretcher-

bar ; such motion is, however, wholly unsuitable for the required operation of the brush. It would not do to reciprocate the brush from the stretcher-bar to the knives and *vice versa*. The brush must, neceesarily, be moved in an orbit or path different from that of the stretcher-bar. In respondents' machine, the movable stretcher-bar is reciprocated by a crank. Such actuating mechanism is suitable because the stretcher-bar is *constantly* in motion from one point to the other. For moving the brush a *different* mechanism (cams) must be used, because the brush is not, and *cannot be*, always in motion. The brush must stand still while acting on the fur on the edge of the stretcher-bar (p. 153, Rcd.), and again in its receded position while the knives operate. For this reason cranks *could not* be used for actuating the brush.

The conclusion is unavoidable that the mechanism for moving the stretcher bar, used in respondents' machines, could not be employed for moving the brush. And all that, what precludes the use of the mechanism designed for moving the *stretcher bar* in respondents' machine for moving a *brush* in such machine, also precludes its use for that purpose in such a machine as set forth in the patent in suit.

This shows that that the moving mechanisms of such machines are not interchangeable, and that there *must* be different moving mechanisms in each machine.

2. In a machine having a fixed stretcher bar and a movable brush several and differently acting moving mechanisms must be provided, while only one moving mechanism is required in a machine having a movable stretcher bar and a fixed brush.

The claim in issue here specifies only the mechanism for moving the brush, but the mechanism for moving the " vertically reciprocating " knife *must also be considered* in the discussion of this topic. Without this mechanism for moving the knife, the brush *could not*

operate at the edge of the stretcher bar to separate the stiff water hairs from the fur.

The operations of an unhairing machine comprises two actions (1) the separating of the water hairs from the fur ; and (2) the removing of the water hairs. Both actions must be performed at the edge of the stretcher bar. Before the water hairs *can* be removed, they must be separated from the fur. To do this, the brush must act on the edge of the stretcher bar. There also must act the knives to remove the water hairs after they are separated from the fur. As both the brush and the knives must act in the same place, *both* of them must be made movable in a machine where the stretcher bar is fixed, as in the machine of the Sutton Patent in suit. The movements of these two parts must conform to the nature of their operations. These are different, and are performed at different times. Therefore *two* separate mechanisms must be provided, one for moving the brush and the other for moving the knife.

For more convenient reference and illustration of these points the reproductions of the figures 1 and 3 of the Sutton Patent drawings are here inserted, showing the parts of the machine in their respective positions.

The mechanism for reciprocating the knife to and from the stretcher-bar which is *indispensable* in a machine where the strecher-bar is *fixed*, like the machine of the Sutton Patent in suit, *is not required* in a machine like respondents' machine, wherein the stretcher-bar is movable. The time and power required for its operation are saved and the speed of the machine so much increased.

In such a machine only *one* mechanism—the mechanism for moving the stretcher-bar—is required, because there is only *one* part—the stretcher-bar—to be moved.

The brush and the cutters, being necessarily in different places, *one* motion of the stretcher-bar, from the brush to the knives (or *vice versa)* enables both, the brush and the cutters, to perform their respective actions at the same place (the working edge of the stretcher-bar), and, of course, at different times.

FIG. 1
OF SUTTON PATENT IN SUIT.
(MACHINE PARTS IN CUTTING ACTION)

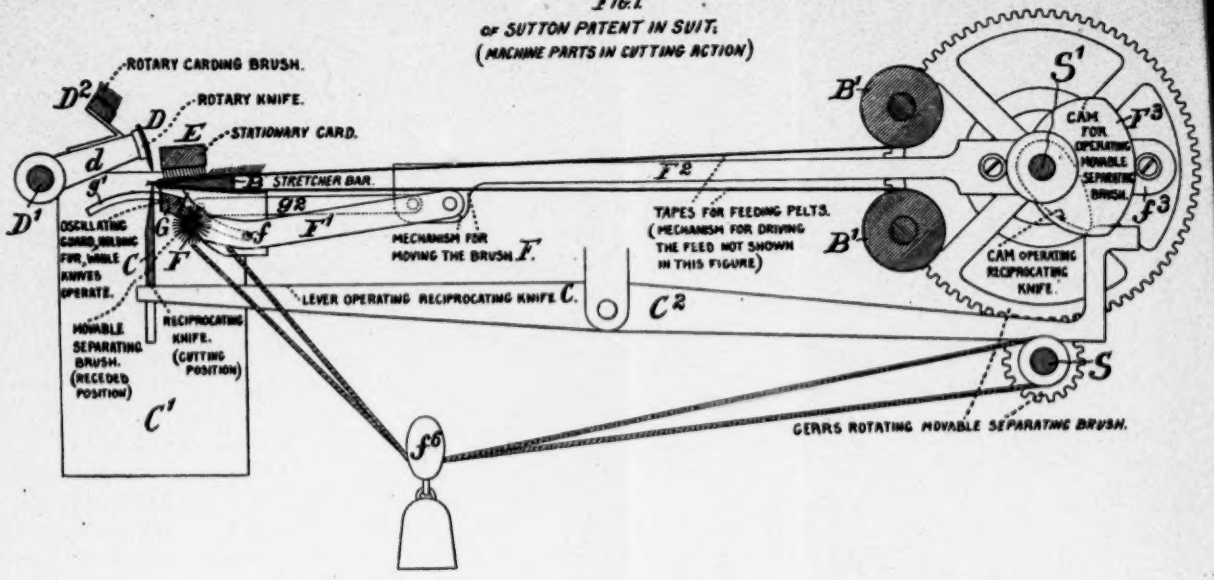
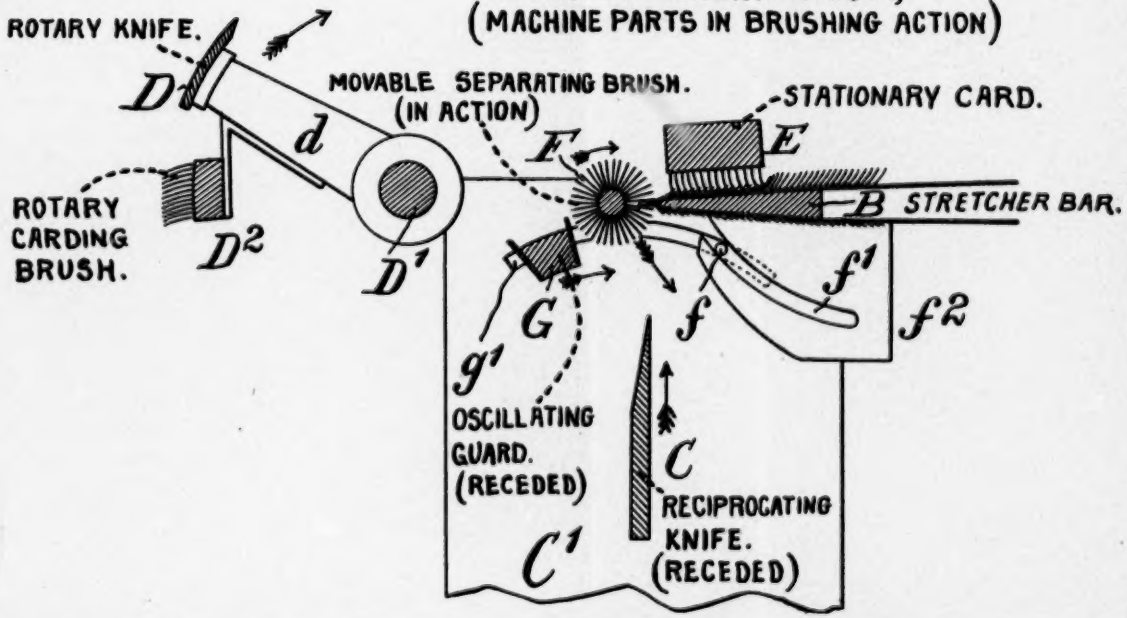


FIG. 3.
OF SUTTON PATENT IN SUIT;
(MACHINE PARTS IN BRUSHING ACTION)



Also the structure of the moving mechanisms must be different. In a machine with a *fixed* stretcher-bar, like, for instance, the Sutton machine, each of the two separate moving mechanisms (one for moving the brush, and the other for moving the reciprocating knife) must be constructed to accomplish its separate object independently of the other moving mechanism. In a machine having a *movable* stretcher-bar, like, for instance, respondents' machine, the mechanism for moving the stretcher-bar accomplishes the objects of both by moving the stretcher-bar from one device to the other. This mechanism operates continuously, each of the others must operate intermittently.

The mechanism for moving the stretcher-bar in respondents' machines also actuates the intermittent feed of the skins, for which the mechanism for moving the brush *cannot be* utilized. Therefore a third mechanism must be provided in a machine where the stretcher-bar is fixed. In the machine of the patent in suit this is done by gear wheel on the driving shaft S and intermediate gears acting on the pawl and ratchet wheel mechanism, that operates the gears of the skin feeding mechanism.

The Court of Appeals says (p. 240, Red.) on this point:

> The essential and central features of respondents' construction—that around which all its mechanism centers—is its *movable* stretcher-bar. Such a reciprocating stretcher-bar, actuated by the same general mechanism, was shown in the Lake Patent. This reciprocating movement carries the pelt in the respondents' machine from the brush to the shears and it feeds the pelt forward over the stretcher edge as well. Its single reciprocating movement covers approximately a quarter revolution of the power shaft. The three separate mechanisms of Sutton for removing the brush to the stretcher-bar, the shears to the same point and feeding the pelt forward are so to speak *unified* in the respondents' single oscillating motion of the stretcher-bar which substantially modifies or effects all three. It is evident that this is not a mere reversal of parts or principles, mere trans-

position or substitution, but is in substance the embodiment of a single three-fold effective movement in lieu of the work of three different individual mechanisms.

3. The substitution of a movable brush and of a fixed stretcher-bar for a fixed brush and a movable stretcher-bar, requires a complete re-organization and re-construction of the machine, addition of new parts, and a changing of the mode of operation of the parts.

What we said, sub. 1 and 2, is probably sufficient to sustain this third proposition. It does not seem to require any more extended argument to show that the substitution of a fixed brush and of a movable stretcher-bar for a movable brush and a fixed stretcher-bar, would require not only a complete re-organization but also an entire re-construction of the machine, addition of new parts, and a change in the mode of operation of the parts.

It would lead too far to attempt to show whether there is more than one way of so re-constructing the machines or how many such ways there are. We think that the proposition is proved by the evident facts: To convert respondents' machine into one having a *fixed* stretcher-bar and a movable brush, it would be necessary

(1) to fix the frame supporting the stretcher-bar and to dispense with the mechanism for moving it;

(2) to provide means for movably supporting the brush and the knives;

(3) to provide mechanism for moving the brush;

(4) to modify or change the frame of the machine and to rearrange the relative positions of the operating parts;

(5) to provide mechanism for moving the knives (or at least one of them) to and from the stretcher-bar and to provide some mechanism for operating the feed.

How and where these additional mechanisms would be required to be arranged is not necessary to exploit; that is not important—the important facts are:

(1) that these additional mechanisms *are required* for such re-construction of the machine, and

(2) that these mechanisms *cannot* be incorporated into the machine without fully re-constructing it.

A machine having a movable stretcher-bar, like respondents' machine, is more simple, is composed of fewer parts, and a less number of motions are required for performing its work; both operations, the separating and the removing of the water hairs are accomplished by one moving mechanism. It contains only one moving part, the stretcher-bar, and only one mechanism for moving it. One-half of its motion brings the stretcher-bar in contact with the brush, for separating the water hairs from the fur, and the other half, or returning motion, brings it to the knives, to remove them. The mechanism also effects the feeding of the skin through the motions of the stretcher-bar.

Can it be said that *one* mechanism, so organized to accomplish that for which in another machine *three* separate mechanisms must be provided, is the equivalent of *one* of these three mechanisms?

Can it be said that a movable stretcher-bar and mechanism for moving it, devised for a machine so arranged that this one mechanism effects the performing of all functions, required to be performed by the machine, is merely a mechanical equivalent of a mechanism *specifically* devised for operating only *one* part of such machine where a larger number of moving parts and separate mechanism for each part are required?

We submit that neither of these propositions can be answered affirmatively.

For these reasons the combination in an unhairing machine, like respondents' machine, of a stationary brush a movable stretcher-bar and mechanism for moving the stretcher-bar, producing the results as are produced in respondents' machines, is not a mere mechanical equivalent of a combination as specified in

claim eight of the patent in suit, wherein there is a fixed stretcher-bar, a movable brush and mechanism for moving *only* the brush.

The Second Element of the Claim in Issue Here is "Mechanism for Intermittently Feeding the Pelt Over the Stretcher-bar."

In respondents' machines a mechanism for intermittently feeding the pelts is used, but the construction of this mechanism is different from that shown and described in the patent, being devised with reference to the different arrangement of respondents' machines, resulting from the determination that the stretcher-bar should be movable. This prior Lake Patent, according to which respondents' machines are constructed, discloses the first machine wherein the stretcher-bar is movable, and in respondents' machine, the movements of the stretcher-bar are utilized to actuate the feeding mechanism. This mechanism is mounted on the movable frame supporting the stretcher-bar and is actuated by a pawl, designated N-4 in the Lake Patent drawings, which is adjustably secured to the main frame of the machine in position to act upon the ratchet wheel O, set on the end of the worm shaft M-3, at every return motion of the stretcher-bar to the brush. The extent of the feed is regulated by the adjustment of the pawl N-4, as may be desired.

In the machine of the patent in suit the same feed mechanism is employed as in other prior machines of the class having the stretcher-bar fixed. In all these machines the feeding mechanism is driven by gears from the main shaft in a manner more or less similar to that shown in the patent in suit.

It might be that in the machine of the patent in suit the mechanism for moving the brush could be utilized for actuating the feed mechanism of that machine, but

the fact is that the feed mechanism shown and described in the patent in suit and the mechanism for moving the brush would have to be reconstructed in some new way to do so, *if it is possible.* In such a case also the gears now used in that machine, to actuate this feed from the driving shaft, would have to be removed.

Though the claim in issue here does not specify the *particular* mechanism for intermittently feeding the pelt as the element of the combination, except as may be inferred from the final clause of the claim "substantially as set forth," the fact that respondents do not, and *could* not, use in their machines the particular mechanism shown and described in the patent, has also bearing on the issue of infringement, in fact, it shows that even in this respect respondents' machines differ in construction and mode of operation from the machine disclosed in the patent in suit.

The Third Element of the Claim in Issue Here is "A Stationary Card Above the Stretcher-bar."

The stationary card, designated E in the drawing of the patent in suit, is secured to the stretcher-bar by thumb screws in a rigid, *immovable* position and so that

> "the points of the teeth of the card E are close to but *do not touch the surface of the skin.*"

The construction of this device *as a "card"* and its *rigid* securing the described position so that its teeth "do not touch" the skin, is required to enable this card to perform the several functions (to straighten out the hair and fur as the skin is fed forward, to separate the fur from the stiff hairs, and to hold the fur down while releasing the stiff hairs) more fully explained in the specification and discussed in the preceding part of this brief.

Speaking of the device the Circuit Court of Appeals says (p. 241, Rcd.):

> "The respondents have found means to unhair pelts by the total omission of the stationary card with its teeth and preparatory work, an essential element of Sutton's eighth claim. The fur and hair are neither straightened, separated or subjected to any preparatory card-work in the respondents' device. They use a repression bar of the same general type shown in the repressing blade of the Covert patent of 1884, and the compression plate of the Lake, English patent of 1881."

In respondents' machines a smooth bar is used. It is the same device as designated in the prior Lake Patent as "compression plate K-2." This plate has no prongs or teeth and (p. 217, Rcd.)

> "is supported by two fingers that reach out from a shaft K-3 which has a handle K-4 on its outer end by which the compression plate may be raised from the bar B, whenever a skin is to be introduced. The said plate is held against the (stretcher) bar by a spring at L, the pressure of which is regulated by a set screw L^1, * * * so that *any desired degree of pressure may* be brought upon the skin during its movement over the supporting bar B."

It is clear from the description, that the construction of this "compression plate" is devised for exerting a tension or pressure upon the skin under operation, and that if in place of this "compression plate" a card or any other implement, having teeth or prongs, be used, it would *prevent* the performance of this function. The card used in the machine of the patent in suit is wholly unable to perform the function of such tension device, pressing upon and stretching the skin. A teethed or pronged bar thus pressed upon the skin would prevent its forward motion or ruin the skin. The card of the patented Sutton machine is set in position that "the points of the teeth are close to *but do not touch the*

skin." This *card* is *rigidly* secured in this position, so the skin may have *free* passage thereunder, and the skin *not come in contact* with the prongs or teeth, whereby its movement would be prevented or the skin damaged.

By reason of being rigidly secured in such position, and by reason of its being provided with teeth or prongs, the card of the patent in suit is enabled to perform the functions (to straighten out the hair and fur, to separate the fur from the stiff hairs and to hold the fur while releasing the stiff hairs) stated in the specification of the patent in suit. These functions again the compression plate, used in respondents' machine, could not perform *by reason of not having any teeth* or prongs, and by reason of being *pressed* upon the skin by a spring. The compression plate of the Lake Patent used in respondents' machines is thus shown, as the Circuit Court of Appeals found, to be a wholly different device from the stationary card, the third element of the claim in issue here. Such device, as the claim specifies as the third element of the combination, is not used in respondents' machines.

The Fourth Element of the Claim in Issue Here is "Rotary Separating Brush."

In the specification of the patent in suit a peculiar brush is described, made of bristles soft enough to "allow" the stiff water hairs to *stand* while the quick motion of the brush bends down *only* the fur and thereby separates it. Such brush was unknown in the prior art.

The prior Covert Patent describes an ordinary bristle brush. The prior Lake Patent describes brushes made of card clothing, bristles or teasels. That would indicate brushes having comparatively stiff bristles or wires and operating in the manner explained in the prior Covert Patent, bending both the soft fur and the stiff hairs, the latter springing up again owing to their greater stiffness and resiliency. Such brushes do not

operate or effect the separating of the water hairs from the fur by such action as Sutton describes, with reference to his novel "soft bristle brush." It is contended by petitioners that such brush or any brush acting as described in the Sutton Patent is a practical impossibility, that the softest and hardest bristle brushes, used by them on such Sutton machines, operate in the same way and that all operate as the brushes of prior art, brushing or bending *both* the fur *and* the hairs in the direction of their motion, and that when released from the action of the brush, the stiff hairs spring back (up) by reason of their greater stiffness and resiliency, while the soft fur remains in the "brushed down" position while the cutters remove the hairs. Petitioners' witness Cimiotti testified to that effect (p. 37, Q. 50 *et seq.*, and p. 58, x-Q. 135 *et seq.*).

Petitioners say that the description of the brush and of its peculiar operation in the patent in suit was not meant to say what it does say, that Sutton meant to describe the ordinary brush known in prior art and operating as such brushes always did. Nevertheless in determining the question of identity of means, we submit, that the Court is required to consider what the patentee says in his application for patent. If he described a device different from those used in prior art and says this device operates differently, he states the premises upon which he bases his right to a patent, and therefore is estopped himself, and any one claiming through him, that such representation as he made to the Patent Office, to obtain the grant of his patent, shall be disregarded in determining the issue of infringement.

In respondents' machine brushes made of *card clothing* are used, by which the separation of the stiff water hairs is affected by the greater resiliency and stiffness of the hairs as explained in the prior Covert Patent.

Though the claim in issue here does not specify the particular brush described in the Sutton specification, the fact, that in respondents' machines such brushes are used as were known in prior art and operating in

the old way, tends to show that respondents do not employ in their machines the means disclosed in the patent in suit.

The Fifth Element of the Claim in Issue Here is "Mechanism, Substantially as Described, Whereby the Rotary Brush is Moved Upward and Forward Into a Position in Front of the Stretcher-bar."

The brush specified in the claim in issue here is a movable brush. The brushes in respondents' machines are stationary. That the mechanism for moving the stretcher-bar in respondents' machines is not a mere mechanical equivalent of the mechanism "substantially as described" for moving the brush in the machine of the patent in suit, and that the combination of a movable stretcher-bar, mechanism for moving the stretcher-bar and a stationary brush is not a mere mechanical equivalent of a combination of a fixed stretcher-bar, a movable brush and mechanism for moving the brush is, we submit, conclusively shown by the propositions discussed in the preceding part of this chapter.

The fifth element "mechanism, substantially as described, whereby the rotary brush is moved, etc.," is thus also shown to be totally absent in the structure of respondents' machines.

The Circuit Court of Appeals for the Third Circuit concluded (p. 241, Rcd.) its consideration of the differences in the *means* employed in respondents' machines as follows:

> "In the means employed by respondent, we find an absence of the specific elements of the claim in suit. The respondents have no fixed stretcher-bar; they have no means for intermittently feeding the skin over such a fixed stretcher-bar; the have no stationary card above the stretcher-bar; they have no movable separating brush below such stretcher-bar; and no mechanism whereby a rotary brush is moved upward and forward in front of such stretcher-bar. This shows

a non-identity of means—and it is fundamental law that the non-use of any specific element of a combination claim or its equivalent avoids infringement (Water-Meter Co. vs. Desper, 101 U. S., 332; Weatherhead vs. Coupe, 147 U. S., 322; Wright vs. Youengling, 155 U. S., 47). The difference between the fixed stretcher-bar and the rotary brush of Sutton and the rotary brush and movable stretcher-bar of the respondents, is not the mere reversal of relations the words indicate. By that change the two separate movements of both shears and brush to the Sutton stretcher-bar and the separate independent mechanical means for accomplishing the two are replaced by the oscillating movement of the stretcher-bar. Nor is this all. The upward and forward movement of Sutton's brush is not translated or reversed into an upward and forward movement of respondents' stretcher-bar, it is substantially done away with in the rocking of the stretcher-bar and that movement also effects an additional result, viz., the forward feeding of the pelt, which in Sutton was done by independent means and which means he makes an element of his claim. It is therefore apparent that the single reciprocating movement of the stretcher-bar which in itself was shown years before in the Lake patent in not a mere mechanical transposition or subterfuge, but embodies the use of substantially different mechanical principles, movements and means in a wholly different way. When these different principles result, as they do in this case, in a double working capacity, and product, the conclusion that there is a difference between the two machines in substance as well as form, is apparent."

One need not be a mechanical engineer or constructor of machinery to understand that one mechanism capable of accomplishing alone the functions of *three*—is not a mere mechanical equivalent of *one* of those three. It is also clear that the arrangement of a machine that facilitates such saving in parts, and results in such greatly increased simplicity in the construction of the machine as here shown, is not a mere reversal of relations of parts—but an entirely different construction of the machine—employment of different means in different ways.

The determination of the issue of infringement by the Circuit Court of Appeals for the Third Circuit is right. Respondents do not use the means, specified in the claim in issue here, nor do they use *any* of the alleged improvement disclosed in the patent in suit.

The Claim in Issue Here Is Restricted by Prior Art to What is Specified Therein.

The claim in issue here does not apply to respondents' machines. Realizing this, and also that respondents' machines are not within the scope of *any* claim of the patent in suit, petitioners pray in their bill that respondents be enjoined from making, using and vending *any* machine containing the combination (1) a stretcher-bar; (2) means for intermittently feeding a pelt over the stretcher-bar; (3) guard device on one side of the stretcher-bar; (4) a rotary separating brush on the other side of the stretcher-bar; and (5) mechanism for causing the rotary separating brush to brush the fur downward from the working edge of the stretcher-bar on to the off-side thereof, that is, on to the side towards which the pelt is fed.

Such construing of the claim in issue here would far exceed the scope of the invention besides rendering the claim void, by reason of being anticipated by prior patents. The claim, if worded as petitioners propose, would be anticipated by the machines of the prior Lake and of the Covert patents.

The Prior Lake Patent Shows and Describes an Unhairing Machine Containing the Combination, That Petitioners Contend the Claim in Issue Here Should Be "Construed" to Cover.

The prior English Letters Patent to Lake (p. 216, Rcd.) are entitled "Improvements in Machinery for Removing the Stiff, Coarse Water Hairs from Fur."

The object of the invention is stated to be to supersede the previously employed hand operation

> "by furnishing a machine which is so organized as to perform the work automatically and rapidly."

The specification then says (p. 216, Rcd.):

> "The said invention consists chiefly in the combination of parts, comprising a *holding device* for supporting the skin, *a brushing or combing agent* for drawing the fur away from the hairs, and a clipping or removing device, to remove them when so separated from the surrounding fur, as hereinafter specified."

The machine embodying this invention is described with reference to a drawing comprising two figures (opposite p. 216, Rcd.), which are described (p. 216, Rcd.), as follows:

> "Figure 1 is an elevation of one end of a machine constructed according to this invention, showing all the operating parts and the fur under the action of the separating brush.
>
> "Figure 2 is a similar view of the portions of the said machine, *with the hairs under the action of the cutters*, when separated from the surrounding fur."

The machine consists of the main frame A, one or two stationary brushes D and D^1; cutters E and E^1 also fixed in their position in the frame A; a rocking frame C; a stretcher-bar B set upon the rocking frame; a driving shaft G; cranks and connecting rods F for rocking the frame C supporting the stretcher-bar; mechanism for feeding and stretching the skin; a pair of feed rollers M and M^1; a worm gear M-2 and M-3; a compression plate K-2 and spring L for pressing it upon the skin; a mechanism, composed of cam Y and levers X, X^1 and X-2 for operating the eccentric of the shaft C, as is more fully explained further on, and of belts, pulleys and other devices for driving and moving the parts.

The cutters are located on the outermost right-hand end of the machine (see drawing opposite p. 216, Rcd.) and the brushes (or brush if only one is used) some distance away to the left. The stretcher-bar, set upon the rocking frame, is reciprocated. At the end of its inward motion (see Fig. 1) it is in operative position relatively to the "farther away brush," during its return swing (or outward motion) it is brought in operative position relatively to the "intermediate brush," and at the end of its outward motion (see Fig. 2) in operative position relatively to the cutters. The inward swing of the rocking frame (from the cutters to the brushes) operates the feed of the skin.

The prior English Lake Patent (p. 216, Rcd.) discloses a machine for unhairing of skins, containing the combination that petitioners contend the claim in issue here should be "construed" to cover. The machine of this prior patent contains:

(1) Stretcher-bar (bar B set upon uprights C).

(2) Mechanism for intermittently feeding the skin over the stretcher-bar (endless apron H, feed rolls M and M[1], toothed wheel M-2, worm M-3 and the ratcher wheel O. This mechanism is actuated by the movements of the stretcher-bar, causing wheel O to engage with pawl N-4 adjustably secured on the main frame).

(3) A "guard device" on the one side of the stretcher-bar (compression plate K-2 combined with a spring L pressing it against the bar).

(4) A rotary separating brush (one or two) on the other side of the stretcher-bar (brushes D and D[1]).

(5) Mechanism for causing the rotary separating brush to brush the fur downward from the working edge of the stretcher-bar onto the off-side thereof, that is onto the side toward which the pelt is fed. (This element of the Lake machine is the mechanism for

moving the stretcher-bar to and from the brush, consisting of the connecting rods F, attached at one end to the upright C, supporting the stretcher-bar, and at the other end to crank pins on shaft G and the mechanism described in the patent, whereby the stretcher-bar, while passing along brush D^1, is also raised and lowered).

The (Movable) "Stretcher-bar" or Holding Device.

The "holding or supporting device for the skin" is the stretcher-bar B, secured to the upper ends of uprights C, supported upon a shaft C^1 rocking in eccentric bearings. The uprights C, the stretcher-bar B and the shaft C^1 thus constitute a movable holding device for the skin. In the frame also the mechanism for feeding the skin is arranged, as explained further on.

The "Mechanism for Intermittently Feeding the Skin."

The skin to be unhaired is secured to an endless apron H, stretched over the bar B and

> "then drawn between two rolls M and M^1, the one at M being provided with a toothed wheel at M-2 which engages with a worm or screw on a shaft M-3, which is supported in bearings * * * on the uprights C * * * ."

These parts comprise the feeding mechanism which is mounted in the reciprocating frame supporting the stretcher-bar.

The Lake specification (p. 217, Rcd.), then explains further, how the mechanism for feeding the skin is intermittently actuated *by the mechanism reciprocating the stretcher-bar.*

> "The worm M-3 receives motion from a spring pawl at N-4 which is fastened upon the frame A at

N-5 by screws in a slot as shown, so that it may be adjustable endwise, and its other end engages with a ratchet-wheel O on the end of the worm shaft * * * ."

The pawl N-4 being stationary (secured to frame A) engages the ratchet-wheel O at every motion of the rocking frame C, from the cutters and causes the ratchet wheel O to turn and the feeding mechanism to act. Thus the feeding of each successive strip of pelt is begun after the stiff hairs have been removed from the preceding strip, and is completed simultaneously with the motion of the stretcher-bar in that direction. The newly fed strip of pelt is then in position to be acted upon by the separating brushes. The speed of the feeding operation is governed by the setting of the adjustable pawl N-4; the more the pawl is receded the shorter will be the action of the feeding mechanism and the narrower strip of the pelt will be advanced or fed, to be acted upon by the brushes and by the cutters.

The advantage of such feed mechanism actuated by the movements of the stretcher-bar rests not alone in the saving of a separate device for driving the feed mechanism—the yet more important advantage is that the feeding is *safely* effected *just at the proper time;* not until *after* the stiff hairs were cut (or otherwise removed) and *before* the separating devices begin their operation. If the feed be operated at any other time, the working of the machine would be rendered ineffectual. If the feeding of the skin should take place before the stiff hairs are cut off, the feeding of the skin at such time would prevent their removal by shifting the strip of skin from the edge of the stretcher-bar to the "off-side" where the cutters cannot reach. The cutters would then act upon a strip of pelt where the water hairs were not yet separated from the fur. And again if the operation of feeding the skin should take place after the separating devices acted, the strip of pelt, whereon the separating of the water hairs from the fur was produced, would be shifted from the edge to the off-side of the stretcher-bar and again a new

strip of pelt containing both fur and hairs, not separated from each other, would be exposed to the action of the cutters. In either case the operation of the machine would be either ineffectual or the fur would be removed with the hairs.

Therefore, the utilizing of the movement of the stretcher-bar to effect the feeding of the skin when it is swung toward the brushes, insures the feeding of the skin at the right moment. This is of greatest importance because if the feeding operation take place at any other time, the machine could not perform the work.

The "Guard Device" (the Compression Plate).

The compression plate referred to above is the plate designated K-2 in the drawings of the patent. It is a smooth bar supported upon two pivots (fingers) and pressed by spring L upon the fur skin on the forward or on-side of the stretcher-bar toward the edge thereof. This "compression plate" is pressed by spring L upon the fur skin to stretch it, to exert tension upon it and, as the specification says (p. 217, Red.) the pressure is regulated

> "so that any desired degree of pressure may be brought upon the skin."

The device also holds the fur and hair away from the upper edge of the stretcher-bar, where the parting is made by the action of the brushes described further on, and to that extent is also a "guard device" though its main function is to stretch the skin.

The "Rotary Separating Brush" (Stationary) on the Other Side of the Stretcher-bar.

The brushes D and D^1, set in stationary bearings upon the main frame of the machine are the "rotary

separating brushes." They are located on the other side of the stretcher-bar and are driven by a belt from a transmission or counter-shaft separate from, and independent of, the main driving shaft of the machine. The specification explains that one of these two brushes—"the one at D, the farther away from the knives, may be dispensed with." They are rotated in the same direction, indicated by arrows in the drawings, and their function is explained to be (p. 218, Red.):

> "to draw the *fur* on the skin over the edge of the bar B and away from the compression plate, and when the fur is so drawn the stiff hairs will stand up *by themselves*, as indicated in the drawings, and in this condition are carried over to the cutters E and E^1 where they are removed."

This is clearly descriptive of a separating action, and the brushes are referred to in the specification as "separating brushes."

It is contended by petitioners, that because "card clothing" and "teasels" are specified *besides* "bristles" as the material for making these brushes, the brushes were intended to perform a *carding* or a *teaseling* action. They say "the covering of the brushing rolls, as shown in the drawings, is comparatively short, therefore they must be card wires or teasels, and their function is described to draw the fur." Therefore these devices are not brushes but cards. This contention is not sustained by the evidence.

What a drawing represents is, of course, a matter of personal impression, but we submit that the drawings of a patent must be considered as representing *what the specification describes.* The specification of the Lake Patent sets forth (p. 218, Red.):

> "Two *brushes* or *brushing* rolls are represented in the drawing at D and D^1, driven by the same belt in the same direction. * * *"

When describing Fig. 1 (p. 216, Red.) the specification says that it shows the fur "under the action of

the *separating brush*." The lines may as well indicate long as short bristles or teasels or wires of card clothing. They show only their ends, projecting beyond the disks on the ends of the brushes. Most likely they indicate card clothing because, as testified (p. 24, Q. 154, *et seq.*) card clothing brushes are the best. They are more effective and produce better work than bristle brushes.

> " x-Q. 154. Have you operated such Lake machine provided with bristle brushes? A. Yes, I have.
>
> " x-Q. 155. Have you also operated such Lake machine with card clothing brushes? A. Yes, I have.
>
> " x-Q. 156. Did you find any difference in the operation of the machine when card clothing brushes are used as compared with machines where bristle brushes are used? A. I found that they came out much straighter and with a better lustre than with a bristle brush.
>
> " x-Q. 157. When you say 'I found they came out much straighter,' you mean for skins unhaired on such machines? A. Yes, I mean the skins that were unhaired on the machines."

That it was not the intention of the inventors of the Lake machine to have these brushes act as " *cards* " is clearly stated in the specification, and is also indicated by the position of the wires or bristles relatively to the direction of their rotary motion.

The brushes are variously referred to in the specification of the Lake Patent, as " fur opening brushes " " separating brushes," " brushes " and " brushing rolls," *always* as *brushes*, never as *cards*. This is admitted by petitioners' expert witness (p. 136, x-Q. 195, Rcd.).

The statement that the fur is " *drawn* " is not indicative of their use or function as " cards " or " carding devices." The words " to draw " and " to brush " *are used as synonyms* in the art of unhairing furs. Proof of that is found in the specification of Covert Patent (p. 198, Rcd.). There (p. 199, Rcd.) the action

of the brush on the fur is described as a drawing action :

> " Every time the brush G passes over the fur at the edge of the plate E, it *draws* over with it as much fur, etc."

and on the same page the resulting condition of the fur is described as " *brushed over* "

> " When the brush G has passed the line of motion of the plate F, this plate * * * carries down the fur just *brushed over*, etc."

And further on, on the same page of the Covert specification, the condition of the fur is again described as "*brushed over*," and further on, referring to the water hairs, the specification describes them as having been "*brushed over*".

As we said before, it is a matter of purely personal impression what a picture is taken to represent, but in the case of patent drawing the question should be determined *solely* by the *words* of the specification. It is not determining what something may be thought to *look* like, but what the specification *says* that it *is*. The specification of the Lake Patent says :

" Two *brushes* are represented in the drawings, etc."

This is *positive*, definite, and leaves no room for *any* assumptions, and least of all for the assuming that the inventors of this machine meant *cards* when they clearly said " *brushes* " and meant " *carding action* " when they clearly describe " *brushing actions*".

" The Mechanism for Causing the Rotary Separating Brush to Brush the Fur Downward From the Working Edge of the Stretcher-bar onto the Off-side Thereof, That is Onto the Side Toward Which the Pelt is Fed."

The movable frame supporting the stretcher-bar and the mechanism are connected by rods F to cranks se-

cured to the driving shaft G, and are thus rocked to the brush D and back again along brush D^1 to the knives. Besides this rocking or latteral motion, the frame supporting the stretcher-bar receives also a rising and lowering motion that causes the edge of the stretcher-bar to gradually descend below its orbit, when the frame moving from the cutters, and to ascend above its orbit, while in contact with the brush D^1 when the frame swings to the cutters. The descending and ascending motions occur opposite the intermediate brush D^1; the descending motion is devised to cause the skin on the stretcher-bar to avoid the intermediate brush (D^1) when the frame is rocked to the brush D when two brushes are used, and the object of the ascending motion (on the return trip) is to extend the contact of the skin with the brush D^1 as may be required or desired, or, as stated in the specification, to produce "a longer or shorter brushing action."

The mechanism whereby the stretcher-bar is thus raised and lowered is described in the Lake specification (p. 218, Red.) as follows:

> "* * * shaft C^1 is mounted on the eccentric bearings as above stated, and upon one end is fastened an arm X to which a link X^1 is attached, connecting it to a lever X-2, which is pivoted to the frame A at X-3. One end of the said lever engages by a pin in a grooved cam Y, fixed on the crank shaft G, and the said cam is so shaped that at each revolution of the shaft, a vibratory motion is given to the lever X-2, and thence to shaft C^1, which by its partial rotation causes the uprights C to gradually descend as the bar moves under the brushing roll D^1 * * *"

The descending of the uprights C (supporting the stretcher-bar) is produced by the convex protuberance of the cam Y, coming in contact with the pin (also designated Y in the drawings) during the motion of the stretcher-bar to the brushes, whereas the concave depression of the cam, located nearly opposite, causes the stretcher-bar to gradually rise. This rising motion

occurs while the stretcher-bar swings along the brush D^1 toward the cutters. The stretcher-bar is thus made to describe "a curve, like a concave to the roll," whereby, as the specification says, "a longer or shorter brushing action can be produced."

The higher the frame supporting the stretcher-bar is thus raised, the longer will be the brushing action and *vice versa.*

The specification of the Lake Patent says that the construction of this mechanism permits the use of only one brush in the machine, and that when it is desired to use only one brush, the brush D, "the farther away from the cutters," may be dispensed with.

Petitioners' expert witness admitted (p. 100, x-Q. 72) that this mechanism is *fully* described in the Lake Patent and (p. 112, x-Q. 127) "that the larger the protuberance and the larger the depression, that is, in mechanical parlance, the greater the throw of the cam, the greater movement is imparted to the stretcher-bar." Mr. Foster further admitted (p. 140, x-Qs. 210, 211, Rcd.) that an increase in the (extent of the) rising and descending motions of the stretcher-bar would be produced by enlarging the size of either the cam (Y) or of the eccentric on the shaft C^1. There may be, and certainly are, other ways known to mechanically trained men, to produce a longer or shorter brushing action by this mechanism, but it is not necessary to exploit all of them. The testimony of Mr. Foster is recited here only to show, that even an adverse witness is constrained to admit that it *can be done by the means shown and described in this Lake patent* and that only knowledge of mechanical constructions is required to understand, from the patent, how to do it.

The Machine Comprises Also Means for Removing the Stiff Water Hairs When Separated From the Fur.

The device for clipping or removing the stiff hairs are the cutters designated E and E^1 in the drawings. They are set in *stationary* bearings. Cutter E^1 is an

immovable straight blade and cutter E is a revolving blade of the kind used in shearing machines, and is driven continuously by a belt from the same transmission or counter-shaft that drives the brushes.

The Operation of the Machine.

The skin, from which the hairs are to be removed is fastened to the endless apron H, and then drawn underneath the compression plate K-2 and over the stretcher-bar B. Then the machine is started.

Every time the stretcher-bar is swung from the cutters to the brushes (or brush, if only one is used) such strip of the fur skin as desired is drawn forward to be operated upon by the brushes. When the stretcher-bar completes its inward swing, the strip of pelt, stretched on the working edge of the stretcher-bar, is acted upon by the brush. The brush (or brushes if two are used)

> (p. 218) "draw the fur on the skin over the edge of the stretcher-bar B and away from the compression plate, and when the fur is so drawn *the stiff hairs will stand up by themselves*, as indicated in the drawings, and in this condition are carried over (by the return swing of the stretcher-bar) to the cutters E and E^1, where they are removed."

Such machine as set forth and shown in the Lake British Patent was constructed and operated in the City of New York in the year 1881 (p. 144, Q. 13 *et seq.*; and p. 147, x-Q. 47 *et seq.*, Red.) and a Letters Patent of United States was allowed but not issued, the final fee not having been paid in the time required by law. The British Letters Patent No. 2836 of June 28, 1881, setting forth the same machine, as will be seen by comparing it with the exhibit, "Abandoned Application," were published in October, 1881. The invention disclosed therein became public property in June, 1885, the grant of the patent having lapsed for non-payment of the taxes required to be paid to keep it in force.

Petitioners' Expert Witness Admits that the Machine of the Prior Lake Patent Contains the Combination Stated in Their Prayer for Injunctive Relief.

It may not require any further argument to show that *in view of the* prior art the claim in issue here cannot be expanded at all, and certainly not as petitioners pray—but it may not be amiss to quote from the testimony of their expert that, which to our understanding proves *conclusively* what we have endeavored to show by our discussion of what the Lake Patent discloses.

Petitioners' witness, Foster, admits in answer to x-Q. 215 (p. 140, Rod.), that the machine of the prior Lake English Patent contains:

> "A. In addition to (1) a stretcher-bar, (2) feeding means, (3) guard, (4) brush, there is (5) mechanism which carries the stretcher-bar and imparts certain movements thereto."

In respect to the mechanism Mr. Foster says (p. 141):

> "x-Q. 217. This mechanism is the mechanism that brings the stretcher-bar in the position relatively to the brush D, shown in Fig. 1 of the Lake English Patent, is it not? A. The mechanism I referred to is the mechanism which, among other things, brings the stretcher-bar to the brush at D, as shown in Fig. 1 of the Lake drawing.
>
> x-Q. 218. This brush D is referred to in the specification of the Lake English Patent more particularly in the description of Fig. 1 as a separating brush, is it not? A. It is so designated at that point.
>
> x-Q. 219. And it is also therein stated that in this position of the parts shown in Fig. 1 the fur is under the action of the separating brush, is it not? A. It is so stated, I would call attention to the fact that both the brushes receive the same designation on line 19, being termed 'the fur opening brushes at D and D^1.'

x-Q. 220. In the position of the parts shown in Fig. 1 the brush D acts on the off-side of the stretcher-bar, does it not? A. The brush would act on that side of the stretcher-bar."

Mr. Foster qualified his last answer with the statement, "I do not wish to be understood as defining what kind of an action," but he admitted (p. 100, Q. 72) that the mechanism, whereby the stretcher-bar is raised and lowered during its reciprocating motion from the cutters, is fully described and shown in the Lake English Patent, and in answer to x-Q. 201 (p. 138), that "the upward movement of the stretcher-bar *causes the fur to be wiped down or brushed down against the side of the stretcher-bar.*" It cannot, therefore, be doubted that, in the machine of the Lake English Patent there is contained a mechanism that causes the brushes or brushing rolls, and either one of them, "to brush the fur downward from the working edge of the stretcher-bar on the off-side thereof."

Additional evidence upon the point is supplied by the testimony of Mr. Mischke, who testified (p. 26, x-Qs. 172 to 177), with respect to the "Green Model" of "No. 4 Machine" built *strictly* according to the specifications and drawings of the prior Lake Patent, and operated with one and with two brushes, as follows:

"x-Q. 172. You have testified that in a Lake machine like the one represented on the photographs now before you, where two brushes are used, the fur skin, stretched on the edge of the stretcher-bar, comes first in contact with the brush D. Please state what this brush does? A. The brush D makes the part on the edge of the stretcher-bar, brushing the fur and hair down together.

"x-Q. 173. By the word 'down' do you mean to say down from the working edge of the stretcher-bar to the off-side? A. Yes."

This testimony shows that the brush D of the Lake English machine *is* "caused to brush the fur downward from the working edge of the stretcher-bar on to

the off-side thereof" when the mechanism, actuating the stretcher-bar, brings it in contact with this brush, as shown in Fig. 1 of the Lake Patent drawing. The mechanism that moves the stretcher-bar in the machine of the prior Lake Patent causes also the brush D^1 "to brush the fur downward from the working edge of the stretcher-bar on to the off-side thereof—that is, on to the side towards which the pelt is fed."

In the continued examination of this witness he testified (p. 26, Rcd.) on this point:

> "x-Q. 174. When the stretcher-bar moves away from the brush D the fur skin comes in contact with the intermediate brush D^1, does it not?
>
> "A. Yes, it does.
>
> "x-Q. 175. Please state what action the brush D^1 has on the fur skin stretched over the edge of the stretcher-bar?
>
> "A. When the stretcher-bar leaves the brush D it goes to the brush D^1 and describes a curved motion around part of the circumference of the brush D^1. The brush D^1 does the finishing. It brushes more on the edge of the stretcher-bar and sort of gives the hair more resiliency to spring up.
>
> "x-Q. 176. Does it also brush the fur and hair down from the edge of the stretcher-bar to some extent?
>
> "A. Yes, it brushes the hair to the off-side of the stretcher-bar and down to some extent.
>
> "(Page 27) x-Q. 177. The question related to both the hair and the fur. In your answer you speak only of hair. Please state whether the brush D^1 brushes both the fur and hair down to the off-side of the stretcher-bar to some extent or only the hair.
>
> "A. It brushes the fur and hair to the off-side of the stretcher-bar."

And in his re-direct examination by petitioners' counsel (p. 28, Rcd.):

> "Re-d. Q. 194. Heretofore you testified that in a so-called Lake machine with two brushes the D^1 brush brushed the fur below the edge from one-eighth to three-sixteenths of an inch. As a matter

of fact, is that what the D^1 brush does in a two brush Lake machine?

"A. Yes."

Thus, Mr. Mischke's testimony *confirms* petitioners' expert's admissions that also the brush D^1, the intermediate brush, is caused "to brush the fur downward from the working edge of the stretcher-bar on to the off-side thereof," when the mechanism actuating the stretcher-bar brings it in contact therewith.

Therefore the proofs show that the prior Lake Patent *does* contain the combination stated in respondents' prayer for injunctive relief, and that the claim in issue here, if "construed" as petitioners pray, *would be anticipated by this prior patent* and void in law.

The Prior Lake Patent Sets Forth an Operative Unhairing Machine and Equally Efficient as the Machine of the Patent in Suit.

Petitioners' contention that the machine constructed according to the prior patent to Lake was "inherently defective" because as their expert witness Foster erroneously contended that *carding* or *teaseling* devices were intended to be used in those machines and was on that account abandoned, cannot be sustained. Not only is there documentary evidence in the case that *brushes* were to be used in these machines, but there is also testimony, clear positive and uncontradicted (p. 146, x-Q. 38, Rcd.), to the effect that the machine operated as an unhairing machine and was abandoned *solely* because it "was not accurate enough," not *safe* enough in operation, involving a risk of spoiling a costly skin.

"x-Q. 38. What was the trouble with the machine or with the business that induced you to abandon the invention?

"A. The machine was not accurate enough. It would cut the stiff hairs and the next minute it would cut a hole in the skin. I saw one skin that I paid $60 for ruined in one second."

That is the same reason as given by petitioner's witness Cimiotti *for not using the machine of the patent in suit* for unhairing of sealskins.

> Page 43. "* * * the only difficulty in unhairing seals on a power machine is that it is more dangerous—that if some wool should spring out occasionally you cannot stop it quick enough to prevent damage to the wool, and therefore a hand machine is preferable, as the man has it more under control all the time." * * *

The testimony of this witness (p. 34, Qs. 18, *et seq.* Rcd.) on the operation of unhairing of seals on the Cimiotti air blast machines is instructive:

> "Q. 18. In the unhairing of seal skins on these machines built in accordance with patent No. 240,007, in the case of almost every pelt as it is fed over the stretcher-bar at some time or other an imperfect part is made, is it not? A. In some skins, yes.
>
> "Q. 19. By an imperfect part you mean that some fur forms a loop on the part, which would be cut if the knives were put into action? A. Yes, sir.
>
> "Q. 20. What does the operator do in such a case when an imperfect part is made? A. Well, he has to make several attempts at it or else work it by hand with a pair of hand shears over those spots.
>
> "Q. 21. You mean to say he either destroys the part and makes a new one or else removes the hair with hand shears? A. That is what I mean."

This evidence shows that for unhairing *seal* skins, only such machines, like the Cimiotti air-blast machines, where the operator works by hand and may *repeat* the separating process until "a part" is made, and may resort to removing the hairs with hand shears if he does not succeed, are suitable.

There is also uncontroverted evidence in this case, that a machine, constructed according to the specifications and drawings of the Lake Patent was used in practical work (unhairing of coneys) and was found to

operate effectively in every respect, *whether used* with one or with two brushes *with bristles or cord clothing brushes.* The machine is shown in Defendant's Exhibit, "Photographs of Lake Model Machine."

The Machine Operated Successfully.

The testimony on this point (p. 23) is as follows:

"x-Q. 144. Did you operate this machine after it was constructed? A. Yes.

"x-Q. 145. Did it unhair skins? A. Yes.

"x-Q. 146. Did it work satisfactorily? A. Yes, in fact, it worked very satisfactorily."

Page 25. "x-Q. 161. Can you state approximately how many fur skins in all were unhaired on those machines constructed by you according to the Lake English patent since you became familiar with this patent and since you have constructed the first model machine mentioned in this testimony?

"A. I could not say exactly; about forty thousand dozen.

"x-Q. 162. Can you state the percentage of fur skins that were spoiled in unhairing, if any?

"A. Sometimes one or two or three out of one hundred dozen.

"x-Q. 163. Can you explain the cause of spoiling such skins? Is it due in your understanding to a defect in the construction of the machines disclosed in the English Lake patent or to other causes?

"A. It is not due to the machine whatsoever. There is what we call 'wild hair' in some skins, which is so stiff that it is impossible to keep it down beneath the surface of the knife. Consequently they are cut away.

"x-Q. 164. Does that happen in other machines too?

"A. It happens in every machine that does unhairing. There is no machine built that could avoid cutting the wild hair out."

Brushes made of card clothing were found better suited and more effective for the work than bristle brushes. (P. 24, x-Q. 154.)

"Have you operated such Lake machines provided with bristle brushes?

"A. Yes, I have.

P. 24, "x-Q. 155. Have you also operated such Lake machines with card clothing brushes?

P. 24, "x-Q. 159. Why do you use card-clothing brushes in the machines operated by defendant corporation? Do you find them better or more efficient in the operation of the machines than bristle brushes?

"A. We find that a card-clothing brush goes through the hair better than a bristle brush and allows the stiff hairs to slip out much more rapidly than a bristle brush, and it also does not burnish the water hairs while a bristle brush sometimes does, which causes them to lay down and consequently not to be cut off by the cutters.

"x-Q. 160. Did you observe in the operation of the Lake machines, wherein you used card-clothing brushes, that the card-clothing draws or tends to pull out the wool or fur of the pelt?

"A. No, it does not pull out any wool or fur."

The Machine Unhaired Fur Skins with only one Brush.

P. 23, Rcd. "x-Q. 149. Did you operate the 'Green Model' machine with only the intermediate brush?

"A. Yes, I did. That is what induced me to build a machine with only one brush, because I found it worked much easier and could be operated more rapidly."

Photographs of this machine are in evidence here. The identity of the actual machine with that shown in the photographs is not disputed (p. 30, x-Q. 205). This evidence proves that a machine constructed ac-

cording to the prior English Patent to Lake is an operative and efficient unhairing machine, and that it operates with two brushes or with one brush only, separating the water hairs from the fur and removing them as set forth therein.

The Prior Covert Patent also Shows and Describes an Unhairing Machine Containing the Combination that Petitioners Contend the Claim in Issue Here Should be "Construed" to Cover.

The U. S. Letters Patent granted to Henry W. Covert September 9th, 1884 (p. 198, Rcd.), are entitled "Method of and Apparatus for Removing Hairs from Seal and other Furs."

This patent particularly describes the separating process by means of a brush, and the inventor claims (p. 200):

> "1. In a machine for unhairing furs, the method of forcing over the fur *by means of a brush*, in combination with a support for the fur and means for holding the fur down substantially as herein described."

The machine is illustrated in Figs. 1 to 4 of the patent drawings (reproduced opposite page 198, Rcd.). Figs. 3 and 4, described as enlarged detail views, show the operating parts in their relative positions at the different stages of their actions.

The machine shown and described in this prior Covert Patent also contains:

(1) Stretcher bar (bar E supported in the frame).

(2) Mechanism for intermittently feeding the skin over the stretcher bar (the endless apron S, feed rolls

B and B^1, and the worm and bevel gear designated I^1, I-2, I-3, I-4 and I-5, shown in Fig. 6).

(3) A "guard device" on the one side of the stretcher bar (blade C "pivoted to the frame AA at *pp*, the cutting edge resting permanently on the fur for the purpose of holding it * * *").

(4) A rotary separating brush (the brush G mounted on shaft G^1).

(5) Mechanism for causing the rotary separating brush to brush the fur downward from the working edge of the stretcher-bar, etc. (The gear wheels shown in Fig. 5 of the patent—one set on the shaft G^1, the other on the shaft F^1 and the third being an intermediate gear in contact with the two others, and transmitting the motion as necessary in the operation of this machine, so that both the brush G and the wiper F rotate and act upon the fur in the same direction).

In this machine the stretcher-bar is fixed and the brush is movable.

The parts of the machine are mounted in a frame consisting of two uprights A secured together by bolts.

The fixed stretcher-bar is shown at E, and the movable separating brush G, mounted on shaft G^1, revolves in the direction indicated by arrows in the drawings. On the "on-side" of the stretcher-bar (where the skin is fed toward the edge thereof), the stationary cutter blade C is located to hold the fur and hair on that side of the stretcher-bar, away from the edge. The movable cutter D is mounted on arms fastened to rock shaft D^1. B and B^1 are feed rollers to which the two ends of the belt S^1 are secured. The feed rollers are driven by the mechanism shown in Fig 1. Belt S^1 and the skin to be unhaired, fastened thereto, are stretched and drawn over the edge of the stretcher-bar E.

The separating brush G, when revolved, passes over the strip of fur skin exposed to its action on the edge of the stretcher-bar. It acts on both, the fur and the

hair, released by the feed from the blade C, over the edge of the stretcher-bar, brushing *both* into the position indicated by letter *t* in Fig. 3 of the drawing. When the revolving brush passes by the greater resiliency of the water hairs causes them to spring back (stand up again), on the edge of the stretcher-bar.

The specification of the patent says on this point (p. 199, Rcd.):

> "Every time the brush G passes over the fur at the edge of the plate E it draws over with it as much fur, together with the accompanying hairs, as have been released from the blade C during one revolution. * * * each layer of fur, as it is brushed over, remains isolated until the plate *f* reaches it, as shown by the line *t*, Fig. 3. In this isolated condition it has not sufficient strength to resist the elasticity of the hairs *which have been brushed over with it*, and which consequently instantly spring up within range of the cutting-blades."

The soft fur remains in the position where it was brought by the brush G, and oscillating wiper *f*, set in the shaft F, then moves in the direction indicated by the arrow in the drawing, and carries the fur farther down and farther away from the edge of the stretcher-bar. This is done while the knives C and D shear off the water hairs standing up on the edge of the stretcher-bar.

The Brush and Wiper of the Covert Patent Perform the Same Function in Removing the Fur from the Edge of the Stretcher Bar as Claimed for the Brush F and the Oscillating Guard G of the Patent in Suit.

In respect to this Covert Patent, it is contended by petitioners, that in the arrangement of this machine the fur is not moved by the brush *as far* below the

edge of the stretcher-bar as it is done in the prior Lake Patent, or in the machine of the patent in suit. When, however, it is considered that in both, the Covert and the Sutton Patent in suit, the necessary function of the brush is to brush the fur within the reach of the supplementary device (wiper F in the Covert Patent and guard G in the Sutton Patent), which supplementary devices are designed in both patents to carry the fur farther away from the edge of the stretcher-bar and to hold it in position while the cutting devices operate, the difference in extent, is immaterial.

The difference in the extent to which the brush acts in moving the fur is immaterial as long as in *both* machines the brush moves the fur *within the reach of the supplementary device.* In the machines of both patents the supplementary devices follow the brush *in its action on the fur,* take up the fur *where the brush left* it and *they* carry it out of reach of the cutting devices. Thus in *both* machines the desired result, the removing and holding of the fur where the cutting blades cannot injure it is accomplished *by the supplementary devices,* and the operation of the brush in *both* machines extends only to move the fur *within reach* of these supplementary devices.

The Machine of the Prior Covert Patent is a Successfully Operative Unhairing Machine.

Such machine as set forth in the prior Covert Patent was used commercially for unhairing of fur-skins in 1883–4 and 1885 in the City of Brooklyn, N. Y., and, as Judge WHEELER found (98 Fed., 297) on the evidence then before him, the operation of the machine was *mechanically successful.*

Petitioners assert that Covert failed to produce the result because his machine was not *commercially* successful. The Covert machine, like the Lake and

Sutton machines, was invented and operated at a time when only *costly* skins were refined by unhairing—and the pay for this work was sufficient to do it by hand, or by hand and foot power operated machines—while the *risk* of spoiling a skin was great.

These conditions under which Covert labored in his time were shown in the evidence before the Circuit Court of Appeals for the Second Circuit in the case of these petitioners against the American Unhairing Machine Co., and Judge WALLACE alludes to this Covert Patent there (115 Fed., 498) as follows:

> "I do not think the Covert patent has been accorded the consideration which it deserves. It has never been considered by the Courts below except incidentally by Judge TOWNSEND—in the Bowsky case (C. C., 113 Fed., 698), in considering the question whether the omission of the carding brush in the claim of the patent in suit rendered the claim one for a non-operative combination, and in the present case, for the purpose of showing that the Lake patent did not anticipate the patent in suit. *The machines built under it by Covert were operative machines, probably about as efficient as was the original Sutton machine.* Covert experimented in improving his machine, but he was a man of small means, the machines were expensive, and he became discouraged."

It does not seem to require any further argument to show that the claim in issue here, if re-worded as petitioners contend, would be clearly anticipated by both, the prior Lake and the prior Covert, patents.

An Issue of Anticipation that was Raised in the Second Circuit, but not Considered There, and not Decided by any Court.

The Covert machine which, as found by Judge WHEELER (98 Fed., 247), was in existence more than two years before Sutton's application for a patent, and

before his invention of the machine set forth in the patent in suit, contains, as stated by Judge WHEELER, *all elements* of the machine of the Sutton Patent, except that where the rotary-separating brush is, Covert employed a *cloth-covered* brushing roll. The Sutton machine is distinguished from this Covert machine only by reason of having a brush in place of Covert's cloth-covered roll. The Lake English Patent was not before the Court in that case, and the question, whether in view of this prior Lake English Patent, *showing the use of brushes made of bristles for the same purpose as Covert used the cloth-covered cylinder*, this Covert machine is, or is not, a full anticipation of the Sutton machine, was not yet decided.

This unhairing machine, known in these cases as the "Covert Machine" is of great importance as evidence on prior art.

The "Covert Machine" was openly and publicly used in the art in the years 1884 to 1886, *and was a mechanically successful device* for unhairing of skins (See Judge WHEELER's opinion, 98 Fed., 247).

The Court sustained the claim involved here *only* on the ground that

> "the cloth-covered cylinder is not made to appear to be a *full* equivalent to the separating brush; and the effect of the patent, as showing the latter to be an advance upon anything before it in this combination, remains."

This decision was made *before the prior Lake Patent was brought in the case.* On submission of this Lake Patent Judge WHEELER vacated the injunction, granted leave to defendants to amend their answer, but thereafter the case was reargued, pursuant to a stipulation between counsel, before Judge TOWNSEND, *who did not consider*, as far as his opinion shows, the bearing of the Lake Patent upon this part of Judge WHEELER's decision.

This issue was not submitted to the Court of Appeals for the Third Circuit and not decided in this case; so much, however, is certain, that in view of

what is disclosed by this prior Covert machine and the prior Lake and Covert Patents, the claim in issue here cannot be sustained, *unless strictly limited* to the particular mechanism for moving the brush as specified therein.

The "Mechanism, Substantially as Described, Whereby the Brush is Moved, Etc.," is Essential to Sustain the Claim in Issue Here.

Sutton is presumed to have had knowledge of all the prior patents and prior devices known in the art. The specification of his patent and the wording of his claims *clearly show* that he had this knowledge. By the elaborate description of every specific feature of the parts of his "improved" machine and the minute explanations of what each part performs *because* of the one or other specific feature or peculiarity of its construction or co-location, and the pointing out of these specific features in the framing of his claims, he endeavored to carefully *differentiate* the particular devices and their particular arrangement employed in his machine from corresponding devices used in machines known in prior art.

He specified in the claim in issue here, "mechamism, *substantially as described*, whereby the rotary separating brush is moved, etc." We submit, that either this "mechanism, substantially as described, whereby the rotary brush is moved, etc.," is either merely a *mechanical* equivalent of the mechanism used in the Covert machine, and then the claim is void, the Lake Patent showing a *brush* where Covert used the cloth-covered roller; or, if the "mechanism, substantially as described, etc.," of the Sutton Patent, *is* patentably different from the mechanism used in the Covert machine for moving the cloth-covered roller, the claim in issue here can be sustained *only* if strictly limited to such mechanism for moving the brush as shown and described in the patent in suit.

What Petitioner's Contend to be the "Gist" of Sutton's Invention, is a Misconceived Theory of a Device, Incapable of Being Produced in Practice.

On page 10 of petitioners' brief is stated

> "The gist of Sutton's invention and the characteristic feature of the same is to separate fur and hair by means of a rotary brush, in contradistinction to the Cimiotti machine, which did the same thing by means of an air blast."

If this statement means that the feature of Sutton's invention, distinguishing it from the prior art, is *the* rotary brush *of such construction and mode of operation as described in the specification of the Sutton Patent,* a brush capable of performing the operation of separating the water hairs from the fur *in the same manner* as the air-blast of the Cimiotti Patent operates, the case could be decided on this proposition.

The Cimiotti Patent (p. 168 *et seq.*, Rcd.) describes (p. 170) the operation of the air-blast as follows:

> "By depressing the treadle a strong current of air is thrown by the bellows upon the narrow strip of skin which is at the time above the knife-edge, the current forcing the soft hair of the fur down and parting it at both sides of the knife-edge, so as to return the soft hair or wool and protect it against injury in clipping or removing the bristles, which project through the teeth of the combs."

The operation is that the air-blast acts *only* on the soft hair of the fur "the current forcing the soft hair of the fur down and parting it at both sides of the knife-edge," *leaving the stiff water hairs standing.* This is the same operation as Sutton describes with reference to the rotary movable brush (p. 151, Rcd.):

> "The *soft* bristles (of the brush) *allow the stiff hairs to stand* while the quick motion of the brush bends the soft hair in downward direction."

This operation is characteristically different from the operation of the separating brush used in the Covert Patent as described therein (p. 199, Rcd.) as follows:

> "Every time the brush G passes over the fur at the edge of the plate E it draws over with it as much fur, *together with the accompanying hairs*, as have been released from the blade C during one revolution. As the brush leaves the fur, the hairs, by reason of their stiffness and elasticity, spring up * * *."

Thus while in this Covert Patent *both* the fur and hair are drawn over by the brush, and the stiff water hairs, *return* to their natural position, the separating, as explained in the Sutton Patent in suit, is done by the brush acting *only on the fur*, "the soft bristles (of the brush) *allow the stiff hair to stand* while the stiff motion of the brush bends the soft hair (fur)," etc.

If the petitioners agree that this so peculiarly acting brush, made of such soft bristles, as described in the patent in suit, that "allow the stiff hairs to stand" shall be considered as the decisive feature of the Sutton invention set forth in the patent, and as the vital point of the case, there would be no need of considering any other.

But in another part (p. 34) of their brief petitioners repudiate this proposition and contend, that *all* elements of the combination are old and that this peculiarly operating Sutton brush is nothing else but the old rotary separating brush known in prior art.

It is for this purpose that they had Mr. Cimiotti testify (p. 37, Q. 50, *et seq.*, Rcd.) that brushes made of the softest bristles act *in the same manner* as brushes made of the hardest bristles. The brush described in the patent in suit here, the characteristic feature and the "gist of Sutton invention" is thus shown to be merely a theoretical dream, not a practically productible device. This is confirmed by the testimony of Mr. Cimiotti (p. 58, x-Q. 136; p. 59, x-Qs. 137 and 138, Rcd.), where it appears that the brushes actually used in the so-called Sutton machines are such

stiff bristle brushes, acting upon the pelt in the same manner as the brushes of the machines described in the prior Covert Patent.

(P. 58, A. to x-Q. 136 :)

"A. The brush remains in contact with the fur until it has reached the limit of the length of the fur when *the hairs are released.*"

(P. 59, A. to x-Q. 137 :)

"A. The action of the brush on the pelt is such that it tends to separate the fur from the hair in revolving in front of the working edge, thereby releasing the hair, and *after the brush has reached the limit* of length of hair *and* fur they naturally then *spring forward* to be removed by the knives."

(P. 59, A. to x-Q. 138 :)

"A. Yes; the stiff hair naturally *by their resiliency spring forward* the moment they are released, while the fur still has the downward tendency produced by the action of the rotary brush upon it. * * *."

If this evidence proves, as petitioners contend, that the particular soft bristle brush, constructed and operating as explained in the Sutton Patent (in the same manner as the air-blast of the prior Cimiotti machine), and the stiff bristle brushes of the prior art are mechanical equivalents, then, we submit, that "the gist of Sutton's invention" and the "characteristic feature of the same," and the patent granted for it are a nullity, the discovery being something that does not exist and cannot be produced.

It was mainly on this point that confusion and error prevailed in the decisions of the Courts in the Second Circuit. While it was held there that the Sutton brush, operating as described in the patent, is an advance upon what was known in the prior art, because it performs something that no brush of the prior art did perform, it was held at the same time that every

machine, employing *any* brush, even a segmental card (see the decision in the Nearseal case) is an infringement of the claim in issue.

The Invention of the Patent in Suit had no Effect upon the Art; The Machine of the Patent in Suit is not Adapted for the Work for which it was Particularly Designed, and was never Used for any Practical Work. It required Improvements, radical Changes and Modifications Before it Could be Used for Unhairing of Coney Skins.

The machine of the patent in suit was invented some years before the unhairing of coney skins was thought of. Petitioner's counsel says two or three years—whether two or three or more years is immaterial—the important facts are (1) that it was invented *before* and (2) that then, at the date of the invention, only *costly* skins were being unhaired and mainly, if not exclusively, seal skins. The machine of the patent in suit was designed—like all other machines of that period—for unhairing of such *costly* skins—in the first place of seal skins; Cimiotti Co. were then unhairing from eighty to ninety thousands of *seal* skins annually as Mr. Cimiotti testified, and no "other" skins are mentioned in *any* testimony relating to that period. The Bates license fee (p. 33, Q. 6) was stipulated per *seal* skin—the price for unhairing (p. 33, Q. 14) is given for *seal* skins and every feature of unhairing is discussed with reference to *seal* skins. On this point also Mr. Cimiotti's testimony (p. 49, x-Q. 98) is noteworthy. He said with reference to the Hedbavny machines—which are also brush machines, invented *after* the date of the patent in suit:

* * * "They didn't go and build machines for the purpose of unhairing coney skins. They

built those machines to unhair *seal* skins, and when the emergency arose to machine coneys, they naturally took hold of it the same as we did." * * *

It is, therefore, only fair to judge the utility of the invention, disclosed in the patent in suit, according to the capability of the machine to unhair *seal* skins, and its value according to the effect it had on the *seal* unhairing industry.

The U. S. Circuit Court of Appeals for the Third Circuit considered the evidence upon this point (p. 238, Rcd.), and expresses its findings as follows:

"The proofs show, that Sutton's machine had no effect on the seal unhairing art and was practically not used therein. An exclusive license thereto was acquired by the Cimiottis, but the machine's use was confined to some experimental work. It was never used commercially for the unhairing of seals. Gustav Cimiotti testified:

"'I have never unhaired any seal skins commercially on the Sutton machine. Most of the skins that were unhaired on the Sutton machine were done day by day in an experimental way.'

"Indeed, he goes to the length of saying it was not adapted to unhairing seal skins. His testimony in a former case embodied in this record is explicit:

"'Q. The machine built in accordance with the Sutton patent here in suit is not at all adapted to unhair seal skins, is it? A. No, sir.'

"He further testified that the Cimiottis were unhairing from eighty to ninety thousand seal skins a year, and that they were all unhaired on the Cimiotti air-blast machines, 'except a few which were unhaired on the Sutton machine.' The rapid operation of a machine of Sutton's type, as compared with one of the Cimiotti air-blast design, and the gain in output and economy of operation in the former, if it could be successfully used to unhair seal pelts, is apparent. That it could not and has not been practically and commercially used for the unhairing of seals, for which it was invented, because it could not do it safely, is strongly suggested, if not, indeed, proven by the

cautious statement of Mr. Cimiotti. A seal skin is worth approximately $50. A slip, therefore, in a rapidly working power machine means ruin to such a pelt. Mr. Cimiotti testifies:

"'The only difficulty in unhairing seals on a power machine is that it is more dangerous, that if some wool should spring out occasionally you could not stop it quick enough to prevent damage to the wool, and, therefore, a hand machine is preferable, as the man has it more under control all the time.'

"This criticism of a power machine is in line with the testimony of Shaw, who was interested in a machine for unhairing seal skins constructed under the Lake English patent of 1881. In answer to the question:

"'What was the trouble with the machine or with the business that induced you to abandon the invention' Mr. Shaw testified: 'The machine was not accurate enough; it would cut the stiff hairs and the next minute it would cut a hole in the skin. I saw one skin that I paid $50.00 for ruined in one second.'

"Whatever the reason, the fact is unquestioned that the machine of Sutton had no effect on the particular art to which it was addressed, and after its purchase by the Cimiotti firm it remained in disuse for a period of two years, although they were then unhairing from eighty to ninety thousand seal skins a year, and that if it was adapted to that work they could have used it, presumably with much profit. Had commercial conditions so continued, there would have been no pretense for any expansive construction of the claims of this patent."

In the Second Circuit Judge WALLACE said in the case of these petitioners against the American Unhairing Machine Co. (115 Fed., 498):

"Sutton's machine was designed for unhairing 'seal skins and other furs', and was a failure for unhairing seal skins, the only kind which he specifically mentioned and the kind which he had prominently in view. He equipped his rotating cutting blade with a carding brush, which he evi-

dently considered an important feature of his machine, as he includes it in the general statement of the essentials of his invention; but the carding brush in operation defeated the utility of his machine. He provided his machine with a stationary card, having a comb or a set of teeth, the different functions of which he set forth fully in his specifications, but which was practically only useful as a pressure device, and, as such no improvement upon the pressure guard of the Covert patent. The improvements upon his machine for which he obtained subsequent patents show that originally it was unnecessarily complex, and to an extent which seriously impaired its efficiency. * * *

"In a patent applied by Sutton in 1894, covering improvements on the patent in suit, No. 536,742, he states that the important feature 'is the substitution for the stationary card above the stretcher-bar of a rotary brush,' and he makes this statement in the specification: 'When the card which is supported back of the rotary knife in my prior machine (the carding brush with which the rotary knife is equipped) passed the edge of the stretcher-bar it drew out from under the stationary card all the fur and hair on that section of the pelt that were on the edge of the bar. Some of the fur, however, was only partly drawn out, owing to the varying thickness of the pelts, and this partly drawn out fur lay in the form of a loop, which stood out far enough to be reached by the knives, but not far enough to be drawn in by the rotary brush below the stretcher-bar, and so was cut off by the knives. With the rotary brush in place of the stationary card heretofore used by me, this looped fur is drawn back and laid down before the knives reach it, so that the cutting of the fur is prevented and only the stiff hairs are removed.' It is fair to say that this later patent does not appear in the record in this action, but appears in the record of the action of the complainant against Derbohlow; but it is a public record, and as the declaration of the patentee himself, it is much more persuasive evidence than any given by the experts for the complainant to exhibit the merits of the original machine of the patent in suit."

The testimony of petitioners' witness Mr. Cimiotti, who was the moving spirit of their business, expert in the trade and is interested to extol the value of the invention, is to the effect, that though the machine of the patent in suit *was* particularly designed "for plucking of seal skins," it was found "*not at all adapted for that purpose*"; that the machine is not used now and never was used for such work except "in an experimental way", only "a *few* skins" having been unhaired when experimenting with the model of the machine in Mr. Sutton's machine shop.

Mr. Cimiotti's testimony on this subject is:

p. *38*. "x-Q. 70 (Q. 7). 'The machine built in accordance with the Sutton patent here in suit is not at all adapted to unhair *seal* skins, is it? A. No, sir.'

p. *43*. "x-Q. 88. When did you commence to unhair *seal* skins on the Sutton machine? A. I can not tell whether we unhaired before we got the patent, in 1888. I think we did, experimentally, but I am not sure whether it was before 1888, or not.

"x-Q. 89. When did you commence to unhair *seal* skins on Sutton's machines commercially? A. Well, I never unhaired any *seal* skins commercially on the Sutton machine."

p. *44*. "x-Q. 107. These eighty or ninety thousand *seal* skins were all unhaired on the so-called Cimiotti air blast machine, were they not? A. All except a few which we unhaired on the Sutton machine.

"x-Q. 108. By the words 'on the Sutton machine' you intend to designate the one machine built according to the Sutton specification and drawings which you testified you had before the unhairing of coney skins came into market, do you not? A. Yes, sir."

p. *45*. "x-Q. 114. Are you unhairing any *seal* skins on the Sutton machines now? A. No, sir."

p. *53*. "x-Q. 104. Were these experiments conducted in your shop or in Mr. Sutton's place at that time? A. They were made in Mr. Sutton's shop."

p. 67. "x-Q. 172. What kind of a shop did Mr. Sutton have and where was it located? A. It was located on W. 29th St. It was a regular machine shop.

"x-Q. 173. Was it the same shop where Mr. Sutton made his various experiments and constructed machines and other devices which he had patented? A. Yes.

"x-Q. 174. Do you still use the air blast machines built according to your patent No. 240,007, for unhairing of seal skins? A. Yes."

This evidence, we submit, proves conclusively, that as a "*seal* plucking" or unhairing machine the invention of the patent was of less than problematical value in the development of the art. As long as only seals and other costly skins were being unhaired the model of the Sutton machine remained in Mr. Sutton's machine shop—and Cimiottis, the *alleged* licensees of the *now* so highly extolled patent in suit, continued to use their old, slow, hand and foot operated air blast machines. On these old machines twice as many seal skins can be unhaired, as Mr. Cimiotti testified (p. 47, Q. 75) and without risk of spoiling any, as even an *experienced* man could unhair "upon a machine built in strict accordance with the Sutton patent in suit"—

Mr. Cimiotti unhaired "a few" seal skins "experimentally" on the model Sutton machine, he is therefore competent to testify as an expert on this subject.

The difficulty in unhairing *seals* on *any* power machine, we again quote from Mr. Cimiotti's testimony,

"is that it is more dangerous,—that if some wool should spring out occasionally, you *cannot stop it quick enough* to prevent damage * * * "

The Sutton machine was "improved" several times since the date of the patent in suit (see Defendants' Exhibits Sutton 1895 and Sutton 1899 Patents, and Mr. Cimiotti's testimony, p. 40, x-Qs. 57 *et seq.*; p. 57, x-Qs. 128 *et seq.*; p. 58, x-Qs. 138 *et seq.*), but they still use the old *hand-operated* air-blast machines for unhairing of *seal* skins, though the process is much

slower and much more expensive than it would be on any *automatic* brush machine.

We shall again quote from Mr. Cimiotti's testimony on the subject; it explains best why—

> *Page 33:* "Q. 12. The machines built in accordance with your letters patent No. 240,007 in the year 1881 are still in use at the present time, are they not? A. Yes, sir.
>
> "Q. 13. You still unhair pelts upon them? Yes."
>
> "Q. 14. The price that you obtained in 1881, and that you still obtain, for unhairing a sealskin is $1 per skin? A. Well, we have raised the price of sealskins to $1.25."
>
> *Page 34:* "Q. 17. Each machine built in accordance with patent No. 240,007 requires the attention of one operator? *A. One man to every machine.*"
>
> "Q. 22. How many sealskins can an operator in a working day unhair on machines built in accordance with patent No. 240,007? A. About an average of eight skins per day."

Though the work is very slow, it pays, because by unhairing eight skins per day (at $1.00 or $1.25) the workman and the machine earn from eight to ten dollars, and no skin is damaged or spoiled.

Petitioners endeavored to make out a showing that the coming into use of brush machines was due to something contained in, or achieved by, the construction or arrangement of the parts of the machine of the patent in suit. Such showing is not made out by the evidence in the case. Contrarywise, the evidence here shows that the invention of Mr. Sutton was of no effect whatever, and that his invention was just as barren of any effect as the prior Lake or the prior Covert machines. **The coming into use of automatic brush machines in the unhairing industry is wholly and solely due to the demand for a cheap substitute for seal skin,** for which the cheap rabbit skins, called "coneys," were found suitable. To unhair "coneys" upon the slow working,

hand and foot operated air blast machines was not commercially practicable—it was too costly. The work had to be done cheaply and because the value or cost price of the unrefined skins was very small—not over fifty cents at any time—the risk involved in "machining" these skins was easily negligible. Cimiotti air blast machines could not be used *commercially* for unhairing of coneys. The pay for unhairing of coneys is only $1.80 *per dozen* (p. 36, Q. 46). Thus, one workman and one machine would not earn *at best* more than $1.20 a day—not enough to pay the man's wages. With *automatic* machines it is, however, different. One workman can run *three* of them (p. 36, Q. 48), and *each* machine unhairs eight *dozen*. That is, at $1.80 a dozen, one workman earns $43.20 per day, while the *risk* of spoiling a skin is less than 50 cents.

This opportunity, and no invention of Sutton, brought the automatic brush machines into use.

Mr. Cimiotti testified (p. 42, x-Q. 79, Red.):

> "When the coney industry came into market, we naturally thought that the Sutton machine, *being an automatic machine*, would be better adapted, and we made experiments with coneys and found it satisfactory, upon which, order was given for a number of them for coneys."

and, in answer to Q. 74 (p. 47, Red.), he says, referring to Sutton machines:

> "* * * and they were certainly better adapted, from a *commercial* stand-point, for unhairing coneys, as we could operate *three machines with one man*, which made the expense proportionately small."

This advantage is common to *all* automatic machines. It is possessed in equal degree by the Hedbavny ma-

chine (p. 51, x-Q. 86 *et seq.*, and p. 52, x-Q. 91) that was invented after the Sutton patent in suit, as well as by the machines of the prior Lake and Covert patents.

If the demand for unhairing of coney skins had not arisen or the unhairing of coney skins had not been started by Hedbavny, the inventor of another automatic brush machine, *the machine, invented by Sutton, would not have come into any use at all.*

We again quote from Mr. Cimiotti's testimony:

> *Page 39:* "Q. 19. What do you call coney skins in the trade? A. They are sold in garments under the name of 'electrical seal.'"
>
> "x-Q. 42. How long is it since the business of unhairing coney skins on machines was commenced?
>
> "A. About nine years ago" (this testimony was taken in 1899).
>
> "x-Q. 44. Do you know that Hedbavny invented a machine for unhairing of skins by means of a heated electric wire? A. Yes.
>
> "x-Q. 45. Is it not a fact that the coney skins unhaired on this electric machine were instrumental in giving the name 'electric seal' to the product; I mean to the unhaired coney skins? A. I believe so; yes."
>
> *Page 40:* "x-Q. 51. Did you purchase the business and patents of the North American Electric Seal Unhairing Co. A. Yes, sir.
>
> "x-Q. 52. Did you also purchase the machines and implements? A. Yes, the whole plant."

This Hedbavny machine, used by the North American Electric Seal Unhairing Co., probably reminded the petitioners of the Sutton machine, but whether it be so or not, the afore quoted testimony clearly shows that it was the demand for the unhairing of the cheap coney skins that brought into use the *automatically* working brush machines, and not the invention of the machine set forth in the Sutton Patent in suit.

The Machine Shown and Described in the Patent in Suit Required Improvements, Changes and Modifications Before it Could be used for Unhairing of Coney Skins.

As quoted above, Mr. Cimiotti testified that "when the coney industry came into market they made experiments with coneys." These experiments resulted in contracting for the constructing of "machines for coneys" *according to drawings by Horstman & Co., of Newark, N. J.* The contract Mr. Cimiotti refused to produce, under advice by his counsel (p. 49, x-Q. 137 *et seq.*) but there is enough in his testmony to show, that these machines were *not* constructed as shown and described in the patent in suit and that the machine did require improvements, changes and modifications before it could be used for unhairing of coney skins. We quote from his testimony. Page 46 :

"x-Q. 141. Were all the machines used by the Cimiotti Unhairing Company which you call Sutton machines built by Horstmann & Co. in Newark? A. All except the first one.

"x-Q. 142. Were they all built in one lot? A. No, sir; they were ordered at three different times."

Page 45. "x-Q. 120. Are the Sutton machines built for you or the Cimiotti Unhairing Co. by Horstmann & Co., of Newark, as you testified, exactly like the machines set forth and illustrated in the patent in suit? A. Well, they are not exactly according to the drawing. There were some changes made in the course of experimenting on them. We made some changes in the mechanical details, but the original principles of the patent were adhered to."

"x-Q. 115. What brushes do you use ordinarily on the Sutton machines now employed in your factory for unhairing of coney or other skins? A. We use an *ordinary bristle or horse hair* brush.

"x-Q. 116. I understand from the testimony in another case that these brushes used by you in unhairing of skins on Sutton machines consist of four rows of bristles secured to an iron or steel shaft approximately at right angles to each other. Is that correct? A. Yes."

"x-Q. 57. Are the machines you now use constructed substantially in accordance with the specifications and drawings of the second Sutton patent No. 536,742? A. The machines are constructed substantially in accordance with the patent, except that we do not use the brush D2 and there are other minor variations in the construction."

P. 46. "x-Q. 149. In the machines used by Cimiotti Co. which you call Sutton machines, there are in use the devices described as reciprocating rubbers h and h^1 in the specification and drawings of the Sutton patent? A. No, sir."

"x-Q. 150. What do you use in place of the stationary card E on the front side of the stretcher-bar in those machines used by the Cimiotti Unhairing Company which you call Sutton machines? A. We use the stationary rotary brush made in accordance with the 1895 Sutton patent No. 536,742, of April 2, 1895."

There is yet other testimony in the record on this subject (p. 57, x-Q. 127, *et seq.*), but the quoted evidence is, we submit, sufficient, to prove that the machines, used by petitioners are not *the* machines set forth and claimed in the patent in suit, but machines further improved, and substantially changed in respect to their construction and arrangement of their parts and mode of operation. Defendant's Exhibit, "Sutton 1895 patent" (p. 201, Rcd.), and Mr. Cimiotti's testimony on the subject, show that *radical* changes and many improvements were required before those machines could be used for unhairing of coney skins. For unhairing of seal skins they were "not at all adapted" then, and are not adapted now.

There is no basis whatever for petitioners contentions, that "Sutton machines," constructed according to the patent in suit, were "extensively" employed

from the first and been "eminently" successful. The conclusions of the Court of Appeals are abundantly sustained by the evidence in this case. **The alleged invention, disclosed in the patent in suit had no effect whatever upon the art.** Had the conditions of the unhairing business continued as they were then, the forgotten existence of the patent, and of the model of the machine, would never have been disturbed. Nor would the art or the public have suffered any loss thereby.

The Alleged Sutton-Cimiotti "License" and Mr. Cimiotti's Testimony.

In petitioners' brief, page 19 is stated with reference to page 36, Q. 40, Rod.

"Mr. Cimiotti testifies, that *his company* paid to Sutton under the license about $100,000, or about $10,000 on an average per year"—and then x-Q. 102 is quoted. This question is:

"How much money did *Cimiotti Bros.* pay to Mr. Sutton?"

Further on, on the same and the following page, Mr. Cimiotti's testimony is quoted as to the number of coney pelts unhaired (by Mr. Cimiotti?) "on these Sutton machines" and on the "machines made in strict accordance with the patent drawings of the patent here in suit."

Petitioners' counsel repeats on almost every other page *his* conclusions of what these statements prove.

We submit, that these statements and the whole of Mr. Cimiotti's testimony on the subject only go to show, that the evidence is of most unsatisfactory character and that petitioners have *purposely suppressed and avoided all documentary evidence*, because such evidence would have contradicted every statement made by Mr. Cimiotti on this subject. To show this we beg to call the Court's attention first to the

character of Mr. Cimiotti's answer to question on the subject.

> (p. 19, Brief, x-Q. 102). "A. I *cannot* give you the lump sum. It *might* have been *probably* five thousand dollars a year or more. *I do not remember.*"
>
> (*Ibid.* A. to Q. 45). "I *guess* up to this year now, *may* be about eight million skins."
>
> (p. 20, Brief, A. to Q. 29). "Oh, in the neighborhood of a million skins, *I suppose.*"

That all these statements are nothing more than vague guesses, made up for effect, is shown by the evidence.

> *Page 44.* "x-Q. 109. Have you any books or statements showing the number of seal skins or other skins unhaired by you from the time that you made the agreement with Mr. Sutton in 1888 and until you commenced to unhair coney skins? A. No, sir.
>
> "x-Q. 110. You base the statement that Cimiotti Bros. unhaired as many as eighty or ninety thousand seal skins in a year at the time of your agreement with Mr. John W. Sutton in 1888 on your memory or recollection of these quantities, do you? A. Yes, sir."

That the so-called Sutton machines were not built "in strict accordance with the patent drawings," nor even according to what might be *liberally* conceded to be within the scope of the patent in suit herein is shown by the evidence discussed elsewhere in this brief. The exhibit Sutton 1895 Patent shows that even Sutton himself did not consider the structure of these machines to be within the scope of his patent in suit here, and Mr. Cimiotti admitted that their machines for unhairing of coney skins were not constructed even strictly in accordance with this subsequent patent.

Petitioners' counsel repeatedly asserts in his argu-

ment that the variously named sums of money were paid to Sutton as fee *for the license* under the patent in suit. *This assertion is*, aside from the absolute uncertainty of the statement, *wholly unfounded.*

The bill of complaint herein pleads and makes proffer (p. 2, Rcd.) of *an instrument in writing*, made, etc., no or about the 1st day of January, 1897, which is stated to be the exclusive license to the petitioners "The Cimiotti Unhairing Co."

This "instrument in writing" was not introduced in evidence, nor a certified copy thereof (p. 71, x-Q. 197, *et seq.*).

Nor is the agreement of 1888 (referred to in Mr. Cimiotti's testimony (p. 34, Q. 24; p. 41, x-Q. 70; p. 70, x-Q. 191, and elsewhere) made with Cimiotti Bros. introduced in evidence through Mr. Cimiotti testified in answer to x-Q. 191, *et seq.*, that *The Cimiotti Unhairing Co.*, the petitioners herein "are operating under the license obtained from John W. Sutton in 1888." Though all his testimony is most contradictory and shifting, it seems to appear that this agreement of 1888 embraced *all* of Mr. Sutton's patents, prior and subsequent, and *all* inventions and was of the nature of a *contract for services* by John W. Sutton as mechanical expert and that the payments made to Sutton were in nowise license fees at all, but compensation for his expert services. In fact, the patent in suit was only mentioned in the agreement, as one of a number of other prior patents that were then *assigned* to Cimiotti Bros. This cannot be distorted into proof that the payments made to Sutton were fees for the "exclusive license" under the patent in suit.

This attempt to so represent the payments *now* is as much an afterthought as the adaptation of the machine that was never used, and could not be used, for unhairing of seal skins, for the subsequently "discovered" coney skins.

If it is not so, *why* did Mr. Cimiotti and his counsel refuse to introduce the agreement or the pleaded

license or any old scrap of documentary evidence to prove what they allege?

Brief for Petitioners.

I.

On the first page of petitioners' brief is said:

> "The defendants took no oral testimony whatever, but relied upon the British Lake Patent, unexplained, as an anticipation."

That respondents have not taken oral testimony is right; that they relied upon the Lake Patent *as an anticipation* is a misstatement.

Defendants took no oral testimony for two reasons: The first and most deciding reason, was to guard in this case against the tactics pursued by petitioners in their cases litigated in the Second Circuit. There they have retained as many so-called "mechanical experts" as they could find willing to serve their purpose to produce volumes of conflicting testimony by these so-called mechanical experts. The records in those cases are veritable whirlpools of twisting and contradictory "explanations" of every word and every sentence of the prior Lake Patent. Each of these "experts" expounded a different theory on what the drawings represent, and the specifications mean, to *him*, and none, of course, agreed with what a plain mechanic, familiar with the art, not retained to exploit some theory for a purpose, understood from these drawings or read from the specification. The Lake specification is not a model composition, both inventors being foreigners, but any one, not biased, or not retained for a special purpose, can understand from the drawings and from the specification the real construction and operation of the machine.

Respondents were satisfied to submit that document

to the Court without such misleading theoretical expositions of so-called experts. They believe this to be the safer course and a much less tedious task for the Court than would be the wading through a whirlpool of purposely distorted and involved theories made up to create confusion, not to aid the Court. Petitioners were thereby sorely disappointed, and lament being thus deprived of desired opportunity to again produce such confusion, so the Court should be unable to separate the chaff from the wheat or despair of such task. They were aided in their tactics by the multiplicity of the suits in the Second Circuit and the unfortunate circumstance that two and three of these suits came to be heard at the same session and were argued before the same Judges one immediately after the other, and also by the unfortunate circumstance, growing out of this veritable flood of "Cimiotti and Sutton cases," that it was impossible to constitute a bench of three Judges in the Court of Appeals for the Second Circuit without calling on Judges who heard other cases on this patent in the Circuit Court.

The second reason why defendants took no oral testimony was that in this case the *actual* machine, constructed as shown and described in the Lake English Patent, is in evidence. In this exhibit the construction of every part and the arrangement of the parts and also the operations of the machine may be seen and understood more readily by those Judges who are not familiar with reading mechanical drawings. It is also feasible to compare this exhibit with the drawings of the patent, and the manner of its working with what is shown and described in the Lake Patent. It was, therefore, in our best judgment not considered necessary to call witnesses to testify that a crank is a crank and moves when the shaft is turned, and being connected to some other part, causes that part to move also.

II.

Respondents' counsel repeats his chronic error in saying that defendants rely upon the British Lake Patent *as an anticipation.* The Lake English Patent is a part of the prior art, is brought in the case to show what was known and used prior to the Sutton invention and thereby to assist the Court in determining the nature and scope of the invention disclosed in the patent in suit. The validity of the claim eight of the Sutton Patent was not contested in this nor in any other case. The defense is, that the machines made and used by the respondents do not contain the combination specified in that claim and that the terms of the claim cannot be "construed" or "re-worded" as to include such construction, because, *if thus expanded,* the claim *would be* anticipated by prior art.

III.

On the same page and page 2 of the petitioners' brief, the mis-statement is repeated, that in the suit against the American Unhairing Machine Company the Circuit Court of Appeals for the Second Circuit

> "held machines in all respects substantially like respondents machines herein to be infringements"

And also the further mis-statement that

> "The said American Unhairing Machine Co., being practically these same respondents, under color of law, with a new charter and a slightly different name, * * * continued to do what the Federal Courts on the other side of the river had forbidden."

If the record in that case be before the Court here, this mis-statement could be controverted more in de-

tail. What is contained in the record of this case bearing on this matter will be found on page 13, Q. 18 to Q. 41; page 21, Q. 130 *et seq.*; page 23, x-Q. 141, *et seq.*; page 24, x-Q. 150, *et seq.*; page 30, Re-Q. 205.

This evidence shows that the respondents herein are a corporation organized by two former employees of the American Unhairing Machine Co. *long after this corporation ceased to exist*, and long before *any* decision of the Circuit Court of Appeals was rendered in any one of the cases decided there; that no other person, formerly connected with the American Unhairing Machine Co., had any interest whatever in the respondent corporation herein, and that respondents have bought three *model* machines, constructed as experiments, that were *in nowise* involved in any case decided by that Court. Moreover, the testimony (p. 24, x-Q. 151) is that these model machines were not and are not being used at all by the respondents herein.

IV.

Petitioners' counsel "deem it unnecessary to devote an entire chapter to any extended elaboration of Sutton's invention." Instead they discuss (page 6, *et seq.*, Petitioners' Brief) and "elaborate" that the Sutton specification directs to put the skin in the machine head foremost and that the stiff hairs in seal skins point toward the tail. They elaborate on this quotation as if the patentee Sutton had disclosed in the patent something that the world did not know before.

It is not our intention to enlarge here on this supremely ridiculous subject. It is characteristic of petitioners' case. If the patentee Sutton had invented the method of putting the skin in the machine "head foremost" or if he had "discovered" that the stiff hairs in seal skins point toward the tail, that might have added to his fame, but cannot possibly have any bearing on the scope of the claim in issue here. There is no claim in the patent for a method of put-

ting the skin into the machine "head-foremost." Nor is there any proof that those working in the art were ignorant of the universally well known fact that the stiff and other hairs of seals and all other animals "point toward the tail," and that therefore the skin must be fed into the machine "head foremost."

V.

Equally vain is the discussion in petitioners' brief of the difference between a stretcher-bar "tapered to a narrow edge" and one "whose upper edge is slightly rounded." Stretcher-bars of *all* kinds from "keen" or "knife-edged" blade to "dull" and "round-edged" were used for many years prior to the patent in suit.

VI.

Petitioners' counsel's discussion of the Covert Patent is met in another chapter of our brief on the subject. His assertion (p. 9), that Covert *failed* to make a separation between fur and hair is contradicted by the findings of Judge WHEELER in the case of these petitioners against the American Unhairing Machine Co. (98 Fed., 297). Judge WHEELER considered this issue on the evidence there before him, containing the testimony of Covert and other persons who have operated and seen such machines operate.

Judge WHEELER found that the operation of Covert's machine was mechanically successful. A conclusion to the same effect was reached by Judge WALLACE and expressed in his opinion (115 Fed., 505).

VII.

Petitioners quote on page 18 of their brief from the opinion of Judge THOMAS in the Nearseal Unhair-

ing Co. case (113 Fed., 588). "The roller otherwise performs the same office as does the card E" (of the Sutton Patent in suit), and that "the roller, therefore, is a simple equivalent for the card used by the complainants."

This quotation proves only, that even Courts are more liable to commit errors when they undertake to deviate from the safe path of rules proclaimed by this Court of last resort and repeatedly reasserted.

The doctrine of equivalents is full of such pitfalls as the one into which the conscientious Judge has fallen, who so decided the case as quoted above, and into which the majority of the Court of Appeals followed, when affirming the decision.

The claim specifies a *card*. If a mere tension device was considered sufficient, and a card with all the particular functions was not essential to the claim, the claim should have specified a tension device, or if only a device for pressing down the fur was sufficient the claim could have specified a device for pressing down the fur.

But not only does the claim particularly specify a *card*, the specification of the patent cannot be read without one being impressed with the essentiality of *such* a device in that particular place. Moreover, the card of the Sutton Patent does not and cannot act as a tension device upon the skin. The specification particularly says that it is secured so as to be close to, but not to *touch*, the skin. And, again, a tension device pressed upon the skin must necessarily press upon the fur (and the hair), they being intermediate between the skin and the tension device. Sutton card does not "maintain the tension of the skin." It keeps the fur from moving forward "until the feed operates." Its *essential* function is to comb (straighten out the fur and hair as they are fed forward). For that reason it *must* be a *card* and this requirement *cannot* be disregarded in determining what is its mechanical equivalent.

VIII.

The issue stated in petitioners' brief (p. 24) is as twisted as the logic of petitioners' counsel in the argument that the inability of the Lake and Covert machines to become *commercially* successful at the time of their invention is a proof that it is impossible to construct an *operative* machine according to these patents. Such argument hardly requires any answer.

IX.

The evidence cited in petitioners' brief (p. 25) as "proof of the infringement" is merely evidence that a machine constructed according to the prior Lake Patent contains the combination stated in petitioners' prayer for injunctive relief. This proof does not support petitioners' contention that respondents infringe on their patent, but supports the contention that if the claim in issue here be so expanded as petitioners pray, it would be anticipated by prior art.

X.

All that is said in petitioners' brief under the heading "The Errors of the Circuit Court of Appeals for the Third Circuit" may be summed up in saying, that to petitioners' counsel's understanding the Court should have disregarded its own judgment on the evidence in the case and should have adapted as its own the misstatements of facts and erroneous conclusions of law, advanced by petitioners' counsel.

Their unwarranted success, in having the claim in issue here sustained and expanded by construction of the Courts in the Second Circuit seems to have induced petitioners' counsel to believe that the claim in issue here is for any and every machine capable of unhairing coney skins and not merely for a combination of

specific elements. Such arguments as are advanced by petitioners' counsel to show that the decision is erroneous, show only the utter lack of any basis for petitioners' contentions.

XI.

The conclusions of the Circuit Court of Appeals for the Third Circuit are sound in law and amply sustained by evidence, as we have shown in the preceding chapters of our brief. Petitioners' contentions are illusory and fallacious. They have no foundation in law or in the evidence in the case here. The rules declared by this Supreme Court for interpretations of claims in patent cases are essential for the safety of property rights in patents. They are the most potential factor for avoiding multiplications of suits and the *only* means for bringing about uniformity in judicial decisions in patent cases.

The decision of the Circuit Court of Appeals for the Third Circuit, brought for review here, is following these rules, and should be affirmed.

Respectfully submitted,

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